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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91156321
Party	Defendant United States Hispanic Chamber of Commerce Foundation
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Submission	Motion to Extend
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Date	02/28/2008
Attachments	Amended Motion to Extend.pdf (178 pages)(6086236 bytes)

Docket No. 27206-060

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re Application Serial No. 78/081,731 for U.S. HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA, Opposer, vs. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, Applicant.	Opposition No. 91-156,321 **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S AMENDED[1] MOTION TO EXTEND TESTIMONY PERIOD OR TO SUSPEND THE PROCEEDING**

I. PRELIMINARY STATEMENT AND MOTION

Applicant United States Hispanic Chamber of Commerce Foundation ("Applicant"), by its counsel, hereby moves the Board for an extension of 60 days of Applicant's testimony period to conduct third-party testimony depositions that were interfered with and delayed by Opposer The Chamber of Commerce Of The United States Of America's ("Opposer") filing of ten motions to quash the subpoenas issued by Applicant to such third parties. Also, on February 22, 2008, Opposer produced the final versions of its eight testimony depositions taken eight months ago. The testimony depositions were produced without showing what corrections were made. In the alternative, Applicant moves to suspend this proceeding until the resolution of Opposer's motions to quash pending before a federal district court for the District of

[1] This motion is amended to identify the current status of the third-party testimony depositions and to state an additional basis for the motion.

Columbia. Applicant's testimony period is currently set to close on February 28, 2008; Opposer's rebuttal testimony period is set to close on April 28, 2008; and Applicant's rebuttal testimony period is set to close on June 14, 2008.

This motion is made for good cause on the grounds that following Applicant's issuance of testimony and document subpoenas to ten third-party chambers of commerce, Opposer filed ten motions in three federal district courts seeking to quash the document portions of the subpoenas. Opposer has thus prevented Applicant from obtaining the subpoenaed documents and conducting the third-party testimony depositions as scheduled and contemplated. The third-party testimony and corroborating documents are relevant to show the weakness of Opposer's alleged "Chamber of Commerce" names and that they are generic.

Applicant has requested that Opposer agree to continue Applicant's testimony period for the purpose of taking the third-party depositions, but Opposer refused. Further, after Applicant filed its original motion to extend its testimony periods or to suspend this case, Opposer refused to reschedule several third-party depositions even though the new proposed dates fall into Applicant's testimony period. The rescheduling of the third-party testimony depositions was at the request of the third parties.

Further, Applicant received almost at the end of its testimony period the "final" versions of Opposer's eight testimony depositions – without any corrections identified on the transcripts, even though Opposer's witnesses apparently made corrections. Applicant asked Opposer to send the corrections by way of errata or corrected pages which would show the changes made, but none were provided.

Accordingly, Applicant seeks an extension of the remaining testimony dates as follows:

PERIOD	DATE
Period for Discovery to Close	CLOSED

Testimony period for party in position of Plaintiff to close	CLOSED
Testimony period for party in position of Defendant to close	April 28, 2008
Rebuttal Testimony period for party in position of Plaintiff to close	June 28, 2008
Rebuttal Testimony period for party in position of Defendant to close	August 14, 2008

II. STATEMENT OF FACTS

Applicant's testimony period opened on January 30, 2008. To present evidence in support of its case, that very day, Applicant noticed testimony depositions of its three witnesses for February 20, 22 and 28, 2008. Additionally, on February 8, 2008, Applicant issued subpoenas to ten third-party chambers of commerce, located in New York City and the Washington, DC area, requiring them to appear for testimony depositions and to produce a small number of documents on the dates immediately preceding the respective deposition dates. (Exhibit A[2].) The five document requests in the subpoenas mostly sought representative samples of the documents that would trace and illustrate the third parties' respective testimonies, and tracked the documents already found and produced by Applicant.

Prior to issuing the subpoenas, Applicant combed through the publicly available information pertaining to hundreds of chambers of commerce around the country to narrow the list of the potential third-party chamber of commerce witnesses down to ten witnesses. Applicant then contacted the chambers of commerce on the final list to obtain more information, request them to appear for testimony, and arrange dates. Once this was done, on February 8, 2008, Applicant noticed the third-party witness

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[2] Attached as Exhibit A is a representative sample of the subpoenas issued to the third-party chambers of commerce.

testimony depositions. Service of the subpoenas was effected on February 11 and 12, 2008, setting the depositions for February 25 through 28, 2008, respectively.

On February 13, 2008, Applicant received several phone calls from Opposer, in which the latter threatened to file motions to quash if Applicant did not withdraw the **document** portions of the subpoenas. Opposer alleged that Applicant could not require third parties to produce documents at their respective testimony depositions because discovery in this proceeding is closed. However, because Opposer lacked standing to challenge the subpoenas, and because the subject document requests were narrow and did not constitute discovery, Applicant did not withdraw the subpoenas. More importantly, many of the third parties are already producing documents to augment their testimony.

On or about February 14, 2008, Opposer filed four civil miscellaneous actions in the U.S. District Court for the District of Columbia (Exhibit B), three in the U.S. District Court for the Southern District of New York, and one in the U.S. District Court for the Eastern District of Virginia. Opposer then filed ten motions to quash in these three courts.

As a result of the motions to quash, on February 15, 2008, Applicant contacted Opposer with a request to continue Applicant's testimony period to allow it to take the third-party depositions outside of the currently set testimony period. (Exhibit C.) On February 19, 2008, Opposer responded with a pack of ten letters, each of them pertaining to a particular third-party chamber of commerce, refusing Applicant's request and inviting Applicant to petition the Board for an extension. (Exhibit D.) Opposer then sent copies of the letters to each of the ten chambers of commerce.

As of the date of this motion, the four motions pending in the District of Columbia are not yet set for hearing, and Applicant's opposition to Opposer's motions filed there is due on February 28, 2008. Because Applicant's testimony period is set to close on that date, Applicant is precluded from obtaining any documents from the four

Washington, DC witnesses, because some of the third-party witnesses have become uncomfortable complying with the subpoenas as a result of the motions to quash.

The hearing on the motion to quash pending in the Eastern District of Virginia took place on February 22, 2008. The Court denied Opposer's motion to quash. Therefore the testimony deposition at issue there has gone forward as scheduled, and the third-party chamber of commerce already provided the requested documents to Applicant.

On February 19, 2008, without providing Applicant with a chance to submit a written opposition to Opposer's motions to quash before the hearing on the motions, the Court in the Southern District of New York held a hearing on Opposer's motion pending there, after which it granted the motion.

On February 20 and 22, 2008, Applicant took testimony depositions of its two witnesses, and on February 28, 2008, Applicant intends to take testimony deposition of its one remaining witness. By this motion, Applicant thus only seeks extension of time to complete the **third-party** depositions and obtain their documents as requested in the subject subpoenas.

As a result of Opposer's filing the motions to quash and its barrage of letters to the third-party chambers of commerce regarding the motions and the parties' scheduling disputes, several third parties have notified Applicant of their inability to provide the requested documents and/or to appear at the respective depositions on the dates proposed. Further, following Applicant's filing of its motion to extend or to suspend on February 25, 2008, Opposer refused, without providing any explanation, to reschedule the deposition for one of the third-party chambers of commerce and impliedly invited Applicant to petition the Board for an order allowing the rescheduling. (Exhibit E.)

Finally, from June 19, 2008, to June 28, 2008, Opposer took the testimony depositions of eight of its employees. Opposer served Applicant unsigned copies of the

transcripts in July 2007. Opposer served another, presumably revised set of testimony transcripts in September 2007. On February 20, 2008, Applicant asked to receive the second version of the testimony depositions of one of Opposer's witnesses, which was not received in September 2007. Opposer indicated that final corrected transcripts would be received by Applicant on February 22, 2008. Applicant requested errata sheets or corrected pages for the transcripts. (Exhibit H.) On February 22, 2008, Applicant received the final corrected versions of the testimony transcripts for Opposer's eight witnesses, without any errata sheets or corrected pages included. (Exhibit I.) Near the close of business on February 22, 2008, Applicant finally received copies of presumably corrected deposition transcript pages. These copies, however, did not show in any way what changes were made, and Applicant is now left to compare the different versions of the transcripts word for word. (Exhibit J.)

III. THE MOTION SHOULD BE GRANTED

A. Opposer Interfered With the Completion of Applicant's Third Party Testimony Depositions

Applicant is aware of the Board's weariness with the disputes that have taken place between the parties in this and related cancellation proceedings. However, after diligently verifying the correctness of the legal and factual bases for its requests of third-party documents, facing inevitable delays caused by Opposer's filing of ten motions to quash in three federal district courts, and receiving no cooperation from Opposer on rescheduling the depositions or on extending the period during which Applicant could take the third-party testimony depositions, Applicant is forced to bring this dispute before the Board.

Opposer, which no doubt is also cognizant of the Board's warning regarding the parties' disputes, nevertheless found other forums in which to engage in procedural games to disrupt Applicant's testimony schedule and to ultimately prevent Applicant from taking all testimony to prove Applicant's case. Rather than address any third-

party document request issues before the Board , e.g., object to any documents provided by the third parties or move for protective order, Opposer took the back door approach. Regardless of whether Opposer is going to prevail on all of its motions to quash, it is well on its way in impeding Applicant's ability to rightfully obtain important third-party testimony and documents.

Applicant's need for additional time is not in any way caused by the inaction or tardiness on Applicant's part. As explained above in the Statement of Facts section, Applicant diligently noticed the depositions of its and third-party witnesses, and promptly served the subpoenas on the latter. Applicant contacted the third parties before the testimony depositions to streamline the process for them, given the short window of time for testimony.

That Opposer's actions are designed to prevent Applicant from bringing in the evidence of the overwhelming use of names including "Chamber of Commerce," particularly with a geographical or national designation by a multitude of entities around the country for services identical or similar to those of Opposer, can also be seen from the following.

First, Opposer lacks standing to move to quash Applicant's subpoenas. "Even outside the scope of the limited jurisdiction available under [35 U.S.C. §] 24, it is well settled that a party to litigation cannot ordinarily file a motion to quash a subpoena before the jurisdiction that issued it." *In re Subpoena Served on Rum Marketing Int'l, Ltd.*, 2007 WL 2702206 at *4 (S.D. Fla. Sept. 14, 2007) (citations omitted). Under this well-settled principle, a motion to quash should be made by the person to whom the subpoena is directed, and a party may not make such a motion unless he has some personal right or privilege with respect to the subject matter of the subpoena. *See id.*; *Novak v. Capital Mgmt. & Dev. Corp.* 241 F.R.D. 389, 394 (D.D.C. 2007); *In re Application of FB Foods, Inc.*, 2005 WL 2875366, *1 (S.D.N.Y. Nov 02, 2005) (denying a party's motion to quash on the grounds of, *inter alia*, lack of standing); *Nova Prods., Inc. v. Kisma Video,*

Inc., 220 F.R.D. 238, 241 (S.D.N.Y. 2004) (denying a party's motion to quash for lack of standing); *Brown v. Braddick*, 595 F.2d 961, 967 (5th Cir. 1979) (defendants do not have standing because they are not in possession of the materials subpoenaed and have not alleged any personal right or privilege regarding the subpoenaed materials); *see also York Group, Inc. v. York Southern, Inc.*, 2006 WL 3392247 at *2 (E.D. Ark. Oct 26, 2006) (denying a party's motion to quash for lack of standing); *Green v. Baca*, 2005 WL 283361 at *1 (C.D. Cal. Jan 31, 2005) (same); *Diamantis v. Milton Bradley Co.*, 772 F.2d 3, 4-5 (1st Cir. 1985) ("It is well settled under the standing doctrine that a party ordinarily may not assert the legal rights of others."). Further, although some courts have held that a party has standing to quash a subpoena addressed to another if the subpoena "infringes upon the movant's legitimate interests," this test has been only applied in criminal and grand jury proceedings where the Federal Rules of Civil Procedure do not apply. *Green*, 2005 WL 283361 at *1.

As stated above, Opposer's grounds for challenging Applicant's subpoenas is that they allegedly seek discovery outside of the discovery period in the opposition. Opposer did not allege any privilege or other personal right that could be enforced to prevent the subpoenaed third parties from violating any privilege or right. Instead, Opposer states that it would be "severely prejudiced" as it "would not have the opportunity to conduct any follow up discovery about the [subpoenaed] material." (Exhibit F[3] at p. 5.) Yet, there is no prejudice to Opposer: it will have ample opportunity to cross-examine the third parties' respective witnesses about the produced documents, and to further subpoena them during Opposer's rebuttal period. Further, Opposer's "severe prejudice" excuse is not within the very narrow exception to the

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[3] Opposer's motions to quash and accompanying memoranda filed in the three federal courts are almost identical. Attached hereto as Exhibit F are copies of Opposer's motion to quash and accompanying memorandum and declaration filed in a district court for the Eastern District of Virginia. The language quoted above appears on p. 5 of the memorandum in support of the motion.

general rule of standing to challenge a subpoena. Denying the movant's motion to quash under a set of very similar facts, the court in *Rum Marketing* held as follows:

> Therefore, whether one looks at this matter as a lack of jurisdiction to grant the particular relief requested, or alternatively a basic lack of standing under Rule 45 [of the Federal Rules of Civil Procedure], the inevitable conclusion is that the relief requested should be Denied. The pending motion was not a motion filed by the subpoenaing party to compel compliance, nor was it filed by the subpoenaed third party seeking relief from the burdens imposed upon that third party in responding to the subpoena. That denial is, of course, without prejudice to [the movant] pursuing this matter with the USPTO. ... But whether or not the subpoena here should be modified or whether the deposition should be rescheduled to accommodate [the movant] are matters that should only be addressed before the USPTO.

Rum Marketing Int'l, Ltd., 2007 WL 2702206 at *5[4].

Thus, Opposer should have brought its grievances regarding Applicant's purportedly "untimely discovery" requests before the Board, which is closely familiar with this case and which has plenary authority over the trial schedule. Resolving the document request issues before the Board would also certainly avoid having the three federal courts reaching potentially disparate and contradictory results regarding the same issues.[5]

Second, Opposer argued that Applicant is trying to reopen discovery by requesting the third parties to bring documents for their respective testimony depositions. This is not true. The five document requests identified in the subpoenas seek a very small number of documents: four of the categories seek *representative*

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[4] A copy of the *Run Marketing* decision is attached hereto as Exhibit G.

[5] The two district courts that heard Opposer's motions (the courts for the Southern District of New York and the Eastern District of Virginia) already reached two contradictory results: whereas the New York court granted Opposer's motion, the Virginia court denied it, with both courts taking disparate positions, at least in part, on the issue of standing. The Virginia court found the motion to quash moot because the third-party witness produced the documents, but the court also was not persuaded by Opposer's standing argument. A hearing on Opposer's motions in the District of Columbia has still not been set, as explained above.

samples of documents that would illustrate and augment the witness' testimony, and the fifth category asks for documents bearing on the potential bias of the witness. If Applicant had issued a discovery subpoena to the third parties, its document requests would be more numerous and broader in scope.

Third, the production of documents at trial, and therefore at a testimony deposition, is expressly provided for under Rule 45 of the Federal Rules of Civil Procedure. Rule 45 provides, in relevant part:

> A command to produce documents, electronically stored information, or tangible things or to permit the inspection of premises may be included in a subpoena commanding attendance at a deposition, hearing, or trial, or may be set out in a separate subpoena.
>
> A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

Fed. R. Civ. P. 45(a)(1)(C), 45(c)(2)(A) (emphasis added).

As stated in *Puritan Inv. Corp. v. ASLL Corp.*, 1997 WL 793569 *1 (E.D. Pa. 1977), "[t]rial subpoenas may be used to secure documents at trial for the purpose of memory refreshment or trial preparation ... ." Despite this express language in Rule 45 and in cases interpreting it, Opposer takes the position that a third party can never be required to bring any documents to trial or to a testimony deposition. That is simply not the law.

Fourth, nowhere do the Trademark Rules state that the documents cannot be produced after the close of discovery. Indeed, the TTAB rules expressly allow discovery requests to be served up to the last day of the discovery period. 37 C.F.R. § 2.120(a); TBMP § 403.02. Even if rules required documents to be produced before the testimony period, Opposer openly flaunted such a requirement by introducing during its witnesses' testimonies a substantial number of documents that had not been earlier produced to Applicant.

As stated above, Opposer's interference with Applicant's third-party testimony depositions has already resulted in several third parties refusing to produce the requested documents and/or to attend the depositions on the dates specified in the subpoenas. Applicant also will not be able to obtain the documents from the subpoenaed third parties located in Washington, DC until the Washington, DC court's resolution of Opposer's four motions to quash pending there.

Moreover, Opposer has refused to reschedule the deposition of one of the third parties until and unless Applicant obtains an order from the Board allowing it to reschedule the deposition. After learning that the witness for the U.S. Women's Chamber of Commerce could not appear for the deposition in person, but would be willing to do so telephonically, Applicant requested that Opposer agree that the deposition be taken by telephone. Without providing an explanation, Opposer refused and suggested that Applicant first obtain an order from the Board allowing the deposition to be taken telephonically. (Exhibit E.) Hoping to resolve such a simple issue by stipulation and without petitioning the Board, Applicant received no cooperation from Opposer. It is obvious that Opposer's lack of cooperation on these simple evidentiary issues is an attempt to improperly subvert Applicant's ability to present evidence of the weakness and genericness of Opposer's "Chamber of Commerce" names. Applicant's counsel, who represents Applicant in this and the related cancellation proceedings *pro bono*, is forced to spend considerable resources on opposing baseless motions to quash in three jurisdictions, and now to petition the Board to decide the issues that could have easily been resolved between the parties.

Accordingly, Applicant requests that the Board allow Applicant more time only to conduct testimonies of the "unwilling" third parties and those located in Washington, DC.

In the alternative, pursuant to 37 C.F.R. § 2.117, Applicant requests that the Board suspend this proceeding pending the resolution of the four motions to quash

pending before the U.S. District Court for the District of Columbia. This option would be less effective and desirable because, as of the filing date of this motion, it is unclear when the court will set a hearing on the motions, and how long after the hearing is set and conducted will the court issue a decision on the motions.

B. Opposer Served Final Versions of its Testimony Transcripts Without Corrected Pages, Three Weeks Into Applicant's Testimony Period

As an alternative basis for this motion, Applicant requires more time to take testimony because it just received Opposer's final, corrected and signed testimony transcripts five days ago. Although Opposer was asked to provide errata sheets or corrected pages to the transcripts showing the corrections, Opposer did not do so in violation of 37 C.F.R. § 2.125(b); TBMP § 703.01(n).

Thus, Applicant prepared for its testimony period using outdated testimony transcripts. Applicant does not know what changes were made between the first and second versions (July 2007 and September 2007) or between those versions and the final versions served on February 22, 2008. Further, Applicant did not even have one of the transcripts that was supposedly sent in September, 2007.

In short, it is unfair of Opposer to wait until six days before the end of Applicant's testimony period to serve final versions of its testimony transcripts, which also do not show the corrections made by the witnesses. See 37 C.F.R. § 2.125(a); TBMP § 703.01(m) and (n).

IV. CONCLUSION

For the above-stated reasons, Applicant requests that the Board extend Applicant's testimony period and the remaining dates in the proceeding by 60 days. In the alternative, Applicant requests that the Board suspend this proceeding pending the

resolution of Opposer's four motions to quash pending before a federal district court for the District of Columbia.

Respectfully submitted,

Date: February 27, 2008

/s/Jill M. Pietrini
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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 27th day of February, 2008.

/s/Monica Danner
Monica Danner

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document has been served upon the attorney for Applicant by depositing a copy thereof in an envelope addressed to: Erik Kane, Kenyon & Kenyon, 1500 K Street, N.W., Washington, DC 20005-1257, on this 27th day of February, 2008.

/s/Monica Danner
Monica Danner

41211384.1

Exhibit A

Issued by the

UNITED STATES DISTRICT COURT

DISTRICT OF COLUMBIA

The Chamber of Commerce of the United States of America,
Opposer,

V.

United States Hispanic Chamber of Commerce Foundation,
Applicant.

SUBPOENA IN A CIVIL CASE

Case Number:[1] U.S. Patent and Trademark Office, Trademark Trial and Appeal Board
Case No. 91-156,321

TO: The U.S. - Women's Chamber of Commerce
1200 G Street, N.W., Suite 800
Washington, D.C. 20005

☐ YOU ARE COMMANDED to appear in the United States District court at the place, date, and time specified below to testify in the above case.

PLACE OF TESTIMONY	COURTROOM
	DATE AND TIME

☒ YOU ARE COMMANDED to appear at the place, date, and time specified below to testify at the taking of a deposition in the above case.

PLACE OF DEPOSITION	DATE AND TIME
Manatt, Phelps & Phillips, LLP; One Metro Center, 700 12th Street, N.W., Suite1100, Washington, D.C. 20005. See Schedule A attached hereto.	February 25, 2008, 1:00 p.m.

☒ YOU ARE COMMANDED to produce and permit inspection and copying of the following documents or objects at the place, date, and time specified below (list documents or objects):

See Schedule B attached hereto.

PLACE	DATE AND TIME
Manatt, Phelps & Phillips, LLP; One Metro Center, 700 12th Street, N.W., Suite1100, Washington, D.C. 20005.	February 22, 2008, 10:00 a.m.

☐ YOU ARE COMMANDED to permit inspection of the following premises at the date and time specified below.

PREMISES	DATE AND TIME

Any organization not a party to this suit that is subpoenaed for the taking of a deposition shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify. Federal Rule of Civil Procedure 30(b)(6).

ISSUING OFFICER'S SIGNATURE AND TITLE (INDICATE IF ATTORNEY FOR PLAINTIFF OR DEFENDANT)	DATE
Andrew Eliseev — Attorneys for Applicant	February 8, 2008

ISSUING OFFICER'S NAME, ADDRESS AND PHONE NUMBER
Andrew Eliseev
Manatt, Phelps & Phillips, LLP; 11355 W. Olympic Boulevard, Los Angeles, CA 90064;
Telephone: (310) 312-4384

(See Federal Rule of Civil Procedure 45 (c), (d), and (e), on next page)

[1] If action is pending in district other than district of issuance, state district under case number.

PROOF OF SERVICE

DATE PLACE

SERVED

SERVED ON (PRINT NAME) MANNER OF SERVICE

SERVED BY (PRINT NAME) TITLE

DECLARATION OF SERVER

I declare under penalty of perjury under the laws of the United States of America that the foregoing information contained in the Proof of Service is true and correct.

Executed on _____
DATE

SIGNATURE OF SERVER

ADDRESS OF SERVER

Federal Rule of Civil Procedure 45 (c), (d), and (e), as amended on December 1, 2007:

(c) PROTECTING A PERSON SUBJECT TO A SUBPOENA.

(1) Avoiding Undue Burden or Expense; Sanctions. A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The issuing court must enforce this duty and impose an appropriate sanction — which may include lost earnings and reasonable attorney's fees — on a party or attorney who fails to comply.

(2) Command to Produce Materials or Permit Inspection.

(A) Appearance Not Required. A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(B) Objections. A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing or sampling any or all of the materials or to inspecting the premises — or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

(i) At any time, on notice to the commanded person, the serving party may move the issuing court for an order compelling production or inspection.

(ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party's officer from significant expense resulting from compliance.

(3) Quashing or Modifying a Subpoena.

(A) When Required. On timely motion, the issuing court must quash or modify a subpoena that:

(i) fails to allow a reasonable time to comply;

(ii) requires a person who is neither a party nor a party's officer to travel more than 100 miles from where that person resides, is employed, or regularly transacts business in person — except that, subject to Rule 45(c)(3)(B)(iii), the person may be commanded to attend a trial by traveling from any such place within the state where the trial is held;

(iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or

(iv) subjects a person to undue burden.

(B) When Permitted. To protect a person subject to or affected by a subpoena, the issuing court may, on motion, quash or modify the subpoena if it requires:

(i) disclosing a trade secret or other confidential research, development, or commercial information;

(ii) disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party; or

(iii) a person who is neither a party nor a party's officer to incur substantial expense to travel more than 100 miles to attend trial

(C) Specifying Conditions as an Alternative. In the circumstances described in Rule 45(c)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

(i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and

(ii) ensures that the subpoenaed person will be reasonably compensated.

(d) DUTIES IN RESPONDING TO A SUBPOENA.

(1) Producing Documents or Electronically Stored Information. These procedures apply to producing documents or electronically stored information:

(A) Documents. A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

(B) Form for Producing Electronically Stored Information Not Specified. If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

(C) Electronically Stored Information Produced in Only One Form. The person responding need not produce the same electronically stored information in more than one form.

(D) Inaccessible Electronically Stored Information. The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

(2) Claiming Privilege or Protection.

(A) Information Withheld. A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

(i) expressly make the claim; and

(ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

(B) Information Produced. If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information to the court under seal for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(e) CONTEMPT.

The issuing court may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena. A nonparty's failure to obey must be excused if the subpoena purports to require the nonparty to attend or produce at a place outside the limits of Rule 45(c)(3)(A)(ii).

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SCHEDULE A

1. The date of the U.S. Women's Chamber of Commerce's ("USWCC") first use of its name and trademark U.S. WOMEN'S CHAMBER OF COMMERCE, or any other mark or name including CHAMBER OF COMMERCE (the "USWCC Marks").

2. The types of products and services that the USWCC offers, sells or sold under, or bearing or promoted as or under, the USWCC Marks (the "USWCC Products and Services").

3. The USWCC's marketing and/or advertising of the USWCC Products and Services.

4. The number and type of customers of the USWCC Products and Services and/or the number of members of the USWCC.

5. The amount spent by the USWCC to advertise or promote the USWCC Products and Services from inception to the present.

6. Publicity relating to the USWCC Products and Services, including but not limited to, reviews, features, or mentions of the USWCC Products and Services in any medium and all press releases relating to any USWCC Products and Services.

7. Any instances of confusion between the USWCC (or the USWCC Products and Services) and the U.S. Chamber of Commerce (or its products and services).

8. Any instances of confusion between the USWCC (or the USWCC Products and Services) and the U.S. Hispanic Chamber of Commerce (or its products and services).

9. Allegations of trademark infringement or any challenges to the use or registration of the USWCC Marks, if any, by the U.S. Chamber of Commerce against the USWCC.

SCHEDULE B

1. Representative samples of documents and things reflecting the advertising, promotion, offering for sale, and/or sale of USWCC's Products and Services, including but not limited to, catalogs, advertisements, website pages, brochures, tradeshow materials, *etc.*

2. Representative samples of documents and things reflecting the total number of USWCC members from inception to the present.

3. Representative documents and things reflecting any publicity relating to USWCC's Products and Services, including but not limited to, press releases, articles, stories, or the like featuring, mentioning, or reviewing USWCC's Products and Services.

4. Representative samples of documents and things reflecting the geographic scope of USWCC's use of the USWCC Marks.

5. Letters, emails, or the like reflecting communications with the U.S. Chamber of Commerce, membership in the U.S. Chamber of Commerce, or any agreements or licenses with the U.S. Chamber of Commerce.

41204031.1

Exhibit B

KENYON & KENYON LLP
Intellectual Property Law

Erik C. Kane
Direct 202.220.4294
ekane@kenyon.com

1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

February 15, 2008

Via Federal Express

Jill M. Pietrini, Esq.
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

Re: *The Chamber of Commerce of the United States v. U.S. Hispanic Chamber of Commerce*, Cancellation No. 91/156,321

Dear Jill:

Enclosed please find *Notices of Designation of Related Civil Cases Pending in this or any other United States Court* filed today with the United States District Court.

Very truly yours,

KENYON & KENYON LLP

Erik C. Kane

ECK

cc: Andrew Eliseev, Esq.
Edward T. Colbert, Esq.
William M. Merone, Esq.

CO-932
Rev. 4/96

CLERK'S OFFICE
UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

NOTICE OF DESIGNATION OF RELATED CIVIL CASES PENDING IN THIS OR ANY OTHER UNITED STATES COURT

Civil Action No. 1:08mc-00077
(To be supplied by the Clerk)

NOTICE TO PARTIES:

Pursuant to Rule 40.5(b)(2), you are required to prepare and submit this form at the time of filing any civil action which is related to any pending cases or which involves the same parties and relates to the same subject matter of any dismissed related cases. This form must be prepared in sufficient quantity to provide one copy for the Clerk's records, one copy for the Judge to whom the cases is assigned and one copy for each defendant, so that you must prepare 3 copies for a one defendant case, 4 copies for a two defendant case, etc.

NOTICE TO DEFENDANT:

Rule 405(b)(2) of this Court requires that you serve upon the plaintiff and file with your first responsive pleading or motion any objection you have to the related case designation.

NOTICE TO ALL COUNSEL

Rule 405(b)(3) of this Court requires that as soon as an attorney for a party becomes aware of the existence of a related case or cases, such attorney shall immediately notify, in writing, the Judges on whose calendars the cases appear and shall serve such notice on counsel for all other parties.

The plaintiff, defendant or counsel must complete the following:

I. RELATIONSHIP OF NEW CASE TO PENDING RELATED CASE(S).

A new case is deemed related to a case pending in this or another U.S. Court if the new case: [Check appropriate box(e's) below.]

- ☐ (a) relates to common property
- ☒ (b) involves common issues of fact
- ☐ (c) grows out of the same event or transaction
- ☐ (d) involves the validity or infringement of the same patent
- ☐ (e) is filed by the same pro se litigant

2. RELATIONSHIP OF NEW CASE TO DISMISSED RELATED CASE(ES)

A new case is deemed related to a case dismissed, with or without prejudice, in this or any other U.S. Court, if the new case involves the same parties and same subject matter.

Check box if new case is related to a dismissed case: ☐

3. NAME THE UNITED STATES COURT IN WHICH THE RELATED CASE IS FILED (IF OTHER THAN THIS COURT):

---

4. CAPTION AND CASE NUMBER OF RELATED CASE(E'S). IF MORE ROOM IS NEED PLEASE USE OTHER SIDE.

The Chamber of Commerce of the USA v. **US Hispanic Chamber of Commerce** C.A. No. **1:08mc076**

2/15/08 — DATE

Signature of Plaintiff /Defendant (or counsel) — DC Bar. 495156

CLERK'S OFFICE
UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Rev. 4/96

RECEIVED
FEB 15 2008
NANCY MAYER WHITTINGTON, CLERK
U.S. DISTRICT COURT

NOTICE OF DESIGNATION OF RELATED CIVIL CASES PENDING IN THIS OR ANY OTHER UNITED STATES COURT

Civil Action No. 1:08-mc-00078
(To be supplied by the Clerk)

NOTICE TO PARTIES:

Pursuant to Rule 40.5(b)(2), you are required to prepare and submit this form at the time of filing any civil action which is related to any pending cases or which involves the same parties and relates to the same subject matter of any dismissed related cases. This form must be prepared in sufficient quantity to provide one copy for the Clerk's records, one copy for the Judge to whom the cases is assigned and one copy for each defendant, so that you must prepare 3 copies for a one defendant case, 4 copies for a two defendant case, etc.

NOTICE TO DEFENDANT:

Rule 405(b)(2) of this Court requires that you serve upon the plaintiff and file with your first responsive pleading or motion any objection you have to the related case designation.

NOTICE TO ALL COUNSEL

Rule 405(b)(3) of this Court requires that as soon as an attorney for a party becomes aware of the existence of a related case or cases, such attorney shall immediately notify, in writing, the Judges on whose calendars the cases appear and shall serve such notice on counsel for all other parties.

The plaintiff , defendant or counsel must complete the following:

I. RELATIONSHIP OF NEW CASE TO PENDING RELATED CASE(S).

A new case is deemed related to a case pending in this or another U.S. Court if the new case: [Check appropriate box(e's) below.]

- ☐ (a) relates to common property
- ☒ (b) involves common issues of fact
- ☐ (c) grows out of the same event or transaction
- ☐ (d) involves the validity or infringement of the same patent
- ☐ (e) is filed by the same pro se litigant

2. RELATIONSHIP OF NEW CASE TO DISMISSED RELATED CASE(ES)

A new case is deemed related to a case dismissed, with or without prejudice, in this or any other U.S. Court, if the new case involves the same parties and same subject matter.

Check box if new case is related to a dismissed case: ☐

3. NAME THE UNITED STATES COURT IN WHICH THE RELATED CASE IS FILED (IF OTHER THAN THIS COURT):

---

4. CAPTION AND CASE NUMBER OF RELATED CASE(E'S). IF MORE ROOM IS NEED PLEASE USE OTHER SIDE.

The Chamber of Commerce of the USA v. US Hispanic Chamber of Commerce C.A. No. 1:08mc076

2/15/08
DATE

DC Bar 495156
Signature of Plaintiff /Defendant (or counsel)

CLERK'S OFFICE
UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

RECEIVED
FEB 15 2008
NANCY MAYER WHITTINGTON, CLERK
U.S. DISTRICT COURT

CO-13
Rev. 4/96

NOTICE OF DESIGNATION OF RELATED CIVIL CASES PENDING IN THIS OR ANY OTHER UNITED STATES COURT

Civil Action No. 1:08-mc-00079
(To be supplied by the Clerk)

NOTICE TO PARTIES:

Pursuant to Rule 40.5(b)(2), you are required to prepare and submit this form at the time of filing any civil action which is related to any pending cases or which involves the same parties and relates to the same subject matter of any dismissed related cases. This form must be prepared in sufficient quantity to provide one copy for the Clerk's records, one copy for the Judge to whom the cases is assigned and one copy for each defendant, so that you must prepare 3 copies for a one defendant case, 4 copies for a two defendant case, etc.

NOTICE TO DEFENDANT:

Rule 405(b)(2) of this Court requires that you serve upon the plaintiff and file with your first responsive pleading or motion any objection you have to the related case designation.

NOTICE TO ALL COUNSEL

Rule 405(b)(3) of this Court requires that as soon as an attorney for a party becomes aware of the existence of a related case or cases, such attorney shall immediately notify, in writing, the Judges on whose calendars the cases appear and shall serve such notice on counsel for all other parties.

The plaintiff , defendant or counsel must complete the following:

I. RELATIONSHIP OF NEW CASE TO PENDING RELATED CASE(S).

A new case is deemed related to a case pending in this or another U.S. Court if the new case: [Check appropriate box(e's) below.]

- [ ] (a) relates to common property
- [X] (b) involves common issues of fact
- [ ] (c) grows out of the same event or transaction
- [ ] (d) involves the validity or infringement of the same patent
- [ ] (e) is filed by the same pro se litigant

2. RELATIONSHIP OF NEW CASE TO DISMISSED RELATED CASE(ES)

A new case is deemed related to a case dismissed, with or without prejudice, in this or any other U.S. Court, if the new case involves the same parties and same subject matter.

Check box if new case is related to a dismissed case: [ ]

3. NAME THE UNITED STATES COURT IN WHICH THE RELATED CASE IS FILED (IF OTHER THAN THIS COURT):

---

4. CAPTION AND CASE NUMBER OF RELATED CASE(E'S). IF MORE ROOM IS NEED PLEASE USE OTHER SIDE.

The Chamber of Commerce of the USA v. US Hispanic Chamber of Commerce C.A. No. 1:08mc076

2/15/08
DATE

Signature of Plaintiff /Defendant (or counsel)

DC Bar. 495156

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA

Movant,

v.

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION,

Non-Movant.

United States Patent and Trademark Office

Trademark Trial and Appeal Board

Opposition No.: 91/156,321

Serial No.: 78/081,731

MOTION TO QUASH TRIAL TESTIMONY SUBPOENA DUCES TECUM

The Chamber of Commerce of the United States of America ("U.S. Chamber"), moves pursuant to Rule 45(c) of the Federal Rules of Civil Procedure, to quash the subpoena *duces tecum* that The United States Hispanic Chamber of Commerce ("USHCOC") has served on third party, The U.S. – Women's Chamber of Commerce, to prevent the production of the requested documents. Through the issued trial subpoena *duces tecum*, USHCOC improperly seeks to obtain document discovery during the middle of the trial phase of the administrative proceeding referenced in the subpoena and *more than eighteen months* after discovery in that proceeding closed. However, under the rules of the Trademark Trial and Appeal Board ("TTAB") of the U.S. Patent and Trademark Office (the body before which the referenced administrative proceeding is pending), discovery may not be sought and cannot be required after the close of discovery. Further, USHCOC has not sought the permission of the TTAB to reopen the discovery period, undoubtedly because it knew that such a request coming at this late date (and without good cause) would have been summarily denied.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA

Movant,

v.

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION,

Non-Movant.

United States Patent and Trademark Office

Trademark Trial and Appeal Board

Opposition No.: 91/156,321

Serial No.: 78/081,731

MOTION TO QUASH TRIAL TESTIMONY SUBPOENA DUCES TECUM

The Chamber of Commerce of the United States of America ("U.S. Chamber"), moves pursuant to Rule 45(c) of the Federal Rules of Civil Procedure, to quash the subpoena *duces tecum* that The United States Hispanic Chamber of Commerce ("USHCOC") has served on third party, U.S. – Mexico Chamber of Commerce, to prevent the production of the requested documents. Through the issued trial subpoena *duces tecum*, USHCOC improperly seeks to obtain document discovery during the middle of the trial phase of the administrative proceeding referenced in the subpoena and *more than eighteen months* after discovery in that proceeding closed. However, under the rules of the Trademark Trial and Appeal Board ("TTAB") of the U.S. Patent and Trademark Office (the body before which the referenced administrative proceeding is pending), discovery may not be sought and cannot be required after the close of discovery. Further, USHCOC has not sought the permission of the TTAB to reopen the discovery period, undoubtedly because it knew that such a request coming at this late date (and without good cause) would have been summarily denied.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA

Movant,

v.

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION,

Non-Movant.

United States Patent and Trademark Office

Trademark Trial and Appeal Board

Opposition No.: 91/156,321

Serial No.: 78/081,731

MOTION TO QUASH TRIAL TESTIMONY SUBPOENA DUCES TECUM

The Chamber of Commerce of the United States of America ("U.S. Chamber"), moves pursuant to Rule 45(c) of the Federal Rules of Civil Procedure, to quash the subpoena *duces tecum* that The United States Hispanic Chamber of Commerce ("USHCOC") has served on third party, The U.S. – Azerbaijan Chamber of Commerce, to prevent the production of the requested documents. Through the issued trial subpoena *duces tecum*, USHCOC improperly seeks to obtain document discovery during the middle of the trial phase of the administrative proceeding referenced in the subpoena and *more than eighteen months* after discovery in that proceeding closed. However, under the rules of the Trademark Trial and Appeal Board ("TTAB") of the U.S. Patent and Trademark Office (the body before which the referenced administrative proceeding is pending), discovery may not be sought and cannot be required after the close of discovery. Further, USHCOC has not sought the permission of the TTAB to reopen the discovery period, undoubtedly because it knew that such a request coming at this late date (and without good cause) would have been summarily denied.

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA

Movant,

v.

UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION,

Non-Movant.

United States Patent and Trademark Office

Trademark Trial and Appeal Board

Opposition No.: 91/156,321

Serial No.: 78/081,731

MOTION TO QUASH TRIAL TESTIMONY SUBPOENA DUCES TECUM

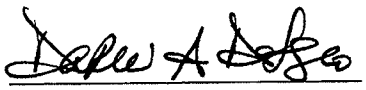
The Chamber of Commerce of the United States of America ("U.S. Chamber"), moves pursuant to Rule 45(c) of the Federal Rules of Civil Procedure, to quash the subpoena *duces tecum* that The United States Hispanic Chamber of Commerce ("USHCOC") has served on third party, American-Russian Chamber of Commerce & Industry, to prevent the production of the requested documents. Through the issued trial subpoena *duces tecum*, USHCOC improperly seeks to obtain document discovery during the middle of the trial phase of the administrative proceeding referenced in the subpoena and *more than eighteen months* after discovery in that proceeding closed. However, under the rules of the Trademark Trial and Appeal Board ("TTAB") of the U.S. Patent and Trademark Office (the body before which the referenced administrative proceeding is pending), discovery may not be sought and cannot be required after the close of discovery. Further, USHCOC has not sought the permission of the TTAB to reopen the discovery period, undoubtedly because it knew that such a request coming at this late date (and without good cause) would have been summarily denied.

CERTIFICATE OF SERVICE

I hereby certify that on February 15, 2008, I caused a true and correct copy of the foregoing Notices of Designation of Related Civil Cases Pending to be served by overnight courier upon the following counsel and parties, as set forth below:

United States Hispanic Chamber of Commerce

Jill M. Pietrini
Andrew Eliseev
MANATT PHELPS & PHILLIPS, LLP
11355 W. Olympic Boulevard
Los Angeles, CA 90064-1614



KENYON & KENYON LLP
1500 K Street, N.W.; Suite 700
Washington, D.C. 20005
Tel.: (202) 220 – 4200
Fax: (202) 220 – 4201

Counsel for Movant, The Chamber of Commerce of the United States of America

Exhibit C

Eliseev, Andrew

From: Eliseev, Andrew
Sent: Friday, February 15, 2008 4:01 PM
To: 'Kane, Erik'
Cc: Pietrini, Jill
Subject: Opposition No. 91-156,321

Erik,

We have received Opposer's motions to quash filed in federal courts in the Eastern District of Virginia, Southern District of New York, and District of Columbia. Having to resolve the third-party testimony issues in court will impede Applicant's ability to receive such testimony (and documents) before the close of Applicant's testimony period. Therefore, we request that Opposer stipulate to continue Applicant's testimony period for 20 days to allow the parties resolve the subpoena issues and conduct the subpoenaed parties' testimonies. This extension will only be necessary to conduct the third-party depositions; the depositions of Applicant's witnesses Frank Lopez, Jose Nino and Monica Danner will go forward as previously noticed.

We hope to obtain Opposer's cooperation on this very necessary and reasonable extension to avoid having to bring this dispute to the Board's attention. Let us know by Monday, February 18, 2008. If not, we will file a motion to extend Applicant's testimony period or to suspend the case based on the newly filed actions to bar our testimony depositions of third parties.

Andrew Eliseev
Manatt, Phelps & Phillips, LLP
11355 West Olympic Boulevard
Los Angeles, CA 90064
Tel. 310-312-4384
Fax 310-996-6986

Exhibit D

KENYON & KENYON LLP
Intellectual Property Law

Erik C. Kane
Direct 202.220.4294
ekane@kenyon.com

1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

February 19, 2008

VIA FACSIMILE & EMAIL

Jill M. Pietrini, Esq.
Andrew Eliseev, Esq.
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The Belgian-American Chamber of Commerce in the United States**, which is presently scheduled for February 27, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

As it would be improper for Applicant to take trial testimony outside of its testimony period, *see* TBMP §707.03(b), 37 CFR §2.121(a), the U.S. Chamber will object to any testimony taken after February 28th unless the Board first agrees to extend the period. Specifically, the U.S. Chamber will move to quash any subpoena that seeks to compel a third part to appear for a deposition after the February 28th cut-off date, and will move to strike any late testimony taken voluntarily. To be sure, if the third party cannot attend on the scheduled date, we would be willing to attend the deposition on a different date, provided that all testimony is completed by February 28th. However, if the third party cannot attend at all prior to February 28th, we would submit that your inability to complete all of your testimony depositions within your proscribed testimony period (which opened last August) is a result of your not pursuing subpoenas until the end of your testimony period and would not provide a valid basis for extending time.

As we have already made arrangements to attend the deposition as noticed, and have not received any indications that the third party is unable to attend, we presume that the deposition will go forward as presently noticed. If you do not intend to take the deposition on the scheduled date and time, please let us know immediately. Should Applicant cancel the deposition only at the last moment and/or fail to attend, the U.S. Chamber will seek appropriate costs and attorney fees with the court that issued the subpoena to the extent permitted under Fed. R. Civ. Pro. 45.

Regards,

KENYON & KENYON LLP

Erik C. Kane

ECK
cc: The Belgian-American Chamber of Commerce in the United States (facsimile only)

KENYON & KENYON LLP
Intellectual Property Law

Erik C. Kane
Direct 202.220.4294
ekane@kenyon.com

1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

February 19, 2008

VIA FACSIMILE & EMAIL

Jill M. Pietrini, Esq.
Andrew Eliseev, Esq.
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The U.S. – Azerbaijan Chamber of Commerce**, which is presently scheduled for February 27, 2008 in Washington, DC.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

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Regards,

KENYON & KENYON LLP

Erik C. Kane

ECK
cc: The U.S. – Azerbaijan Chamber of Commerce (facsimile only)

KENYON & KENYON LLP
Intellectual Property Law

Erik C. Kane
Direct 202.220.4294
ekane@kenyon.com

1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

February 19, 2008

VIA FACSIMILE & EMAIL

Jill M. Pietrini, Esq.
Andrew Eliseev, Esq.
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The Swedish – American Chambers of Commerce USA**, which is presently scheduled for February 25, 2008 in Los Angeles.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

As it would be improper for Applicant to take trial testimony outside of its testimony period, *see* TBMP §707.03(b), 37 CFR §2.121(a), the U.S. Chamber will object to any testimony taken after February 28th unless the Board first agrees to extend the period. Specifically, the U.S. Chamber will move to quash any subpoena that seeks to compel a third part to appear for a deposition after the February 28th cut-off date, and will move to strike any late testimony taken voluntarily. To be sure, if the third party cannot attend on the scheduled date, we would be willing to attend the deposition on a different date, provided that all testimony is completed by February 28th. However, if the third party cannot attend at all prior to February 28th, we would submit that your inability to complete all of your testimony depositions within your proscribed testimony period (which opened last August) is a result of your not pursuing subpoenas until the end of your testimony period and would not provide a valid basis for extending time.

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Regards,

KENYON & KENYON LLP

Erik C. Kane

ECK
cc: The Swedish – American Chambers of Commerce USA (facsimile only)

KENYON & KENYON LLP
Intellectual Property Law

Erik C. Kane
Direct 202.220.4294
ekane@kenyon.com

1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

February 19, 2008

VIA FACSIMILE & EMAIL

Jill M. Pietrini, Esq.
Andrew Eliseev, Esq.
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The Spain-U.S. Chamber of Commerce**, which is presently scheduled for February 28, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

As it would be improper for Applicant to take trial testimony outside of its testimony period, *see* TBMP §707.03(b), 37 CFR §2.121(a), the U.S. Chamber will object to any testimony taken after February 28th unless the Board first agrees to extend the period. Specifically, the U.S. Chamber will move to quash any subpoena that seeks to compel a third part to appear for a deposition after the February 28th cut-off date, and will move to strike any late testimony taken voluntarily. To be sure, if the third party cannot attend on the scheduled date, we would be willing to attend the deposition on a different date, provided that all testimony is completed by February 28th. However, if the third party cannot attend at all prior to February 28th, we would submit that your inability to complete all of your testimony depositions within your proscribed testimony period (which opened last August) is a result of your not pursuing subpoenas until the end of your testimony period and would not provide a valid basis for extending time.

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Regards,

KENYON & KENYON LLP

Erik C. Kane

ECK
cc: The Spain-U.S. Chamber of Commerce (facsimile only)

KENYON & KENYON LLP
Intellectual Property Law

Erik C. Kane
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February 19, 2008

VIA FACSIMILE & EMAIL

Jill M. Pietrini, Esq.
Andrew Eliseev, Esq.
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The U.S./Austrian Chamber of Commerce**, which is presently scheduled for February 28, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

As it would be improper for Applicant to take trial testimony outside of its testimony period, *see* TBMP §707.03(b), 37 CFR §2.121(a), the U.S. Chamber will object to any testimony taken after February 28th unless the Board first agrees to extend the period. Specifically, the U.S. Chamber will move to quash any subpoena that seeks to compel a third part to appear for a deposition after the February 28th cut-off date, and will move to strike any late testimony taken voluntarily. To be sure, if the third party cannot attend on the scheduled date, we would be willing to attend the deposition on a different date, provided that all testimony is completed by February 28th. However, if the third party cannot attend at all prior to February 28th, we would submit that your inability to complete all of your testimony depositions within your proscribed testimony period (which opened last August) is a result of your not pursuing subpoenas until the end of your testimony period and would not provide a valid basis for extending time.

As we have already made arrangements to attend the deposition as noticed, and have not received any indications that the third party is unable to attend, we presume that the deposition will go forward as presently noticed. If you do not intend to take the deposition on the scheduled date and time, please let us know immediately. Should Applicant cancel the deposition only at the last moment and/or fail to attend, the U.S. Chamber will seek appropriate costs and attorney fees with the court that issued the subpoena to the extent permitted under Fed. R. Civ. Pro. 45.

Regards,

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RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The French American Chamber of Commerce in the United States**, which is presently scheduled for February 27, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

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Regards,

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Erik C. Kane

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cc: The French American Chamber of Commerce in the United States (facsimile only)

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11355 West Olympic Blvd.
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The Argentine-American Chamber of Commerce**, which is presently scheduled for February 27, 2008 in New York, NY.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

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RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The American-Russian Chamber of Commerce & Industry**, which is presently scheduled for February 26, 2008 in Washington, DC.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

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Erik C. Kane

ECK
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11355 West Olympic Blvd.
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The U.S. - Mexico Chamber of Commerce**, which is presently scheduled for February 25, 2008 in Washington, DC.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

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Regards,

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Erik C. Kane

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cc: The U.S. - Mexico Chamber of Commerce (facsimile only)

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Andrew Eliseev, Esq.
MANATT, PHELPS & PHILLIPS L.P.
11355 West Olympic Blvd.
Los Angeles, California 90064-1614

RE: US Chamber v. US Hispanic Chamber, Opposition No. 91/156,321

Dear Jill and Andrew:

You have requested that the U.S. Chamber consent to extending your testimony period to reschedule your third party deposition of **The U.S. – Women's Chamber of Commerce**, which is presently scheduled for February 25, 2008 in Washington, DC.

As you know, the U.S. Chamber does not believe that the subpoena *duces tecum* you served on this third party was proper, which led to the U.S. Chamber filing its motion to quash. We therefore do not believe that the pendency of that motion should constitute valid grounds for rescheduling the deposition such that it takes place outside the designated testimony period, and the U.S. Chamber will not consent to extending your testimony period. You, of course, may petition the Trademark Trial and Appeal Board for an extension, but unless and until that request is granted, the U.S. Chamber will presume that your testimony will close on February 28th, as scheduled. *Accord* TBMP §509.02 ("A party has no right to assume that its motion to extend ... made without the consent of the adverse party will always be granted automatically.").

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Regards,

KENYON & KENYON LLP

Erik C. Kane

ECK
cc: The U.S. – Women's Chamber of Commerce (facsimile only)

Exhibit E

Eliseev, Andrew

From: Kane, Erik [Ekane@kenyon.com]
Sent: Tuesday, February 26, 2008 7:35 AM
To: Eliseev, Andrew; Colbert, Edward
Cc: Merone, William; Neal, Stephen
Subject: RE: Deposition Schedule Changes

Andrew,

Sorry for the delay, but I received your email after the close of business last night. We are not willing to consent to your taking your trial depositions telephonically. In the absence of a Board Order to the contrary, we presume that no telephonic depositions will take place.

Regards,
Erik

From: Eliseev, Andrew [mailto:AEliseev@manatt.com]
Sent: Monday, February 25, 2008 5:59 PM
To: Colbert, Edward
Cc: Merone, William; Kane, Erik
Subject: RE: Deposition Schedule Changes

Ed,

Although the U.S. Women's CoC's witness is not available to testify on the date specified in the subpoena, the witness is willing to testify over the phone on Wednesday, February 27, 2008 at 10 a.m. EST. Please let me know as soon as possible whether you are available to attend the witness' testimony by phone at that time.

Andrew

From: Colbert, Edward [mailto:EColbert@kenyon.com]
Sent: Monday, February 25, 2008 7:25 AM
To: Eliseev, Andrew
Cc: Merone, William; Kane, Erik
Subject: Deposition Schedule Changes

Andrew:

Thank you for letting me know about the cancellation of the Monday depositions. I attach a revised scheulde below showing my current understanding of the schedule. It appears that there are still 3 uncertain depositions. Both Wednesday depositions remain uncertain, and one on Thursday. Since we have to make arrangements to travel to New York, I would appreciate learning as soon as possible if they have been confirmed or if they have been cancelled.

Date	Time	Location	Name
2/25/08	9:00a	DC	United States-Mexico CoC OFF

2/25/08	1:00p	DC	U.S.-Women's CoC	OFF
2/25/08	9:00A	LA	Swedish-American CoC USA	ON
2/26/08	9:00a	DC	American-Russian CoC	OFF
2/27/08	9:00a	DC	United States-Azerbaijan	OFF
2/27/08	9:00a	NY	French American CoC	OFF
2/27/08	**12:00p**	**NY**	**Belgian-American CoC**	**UNCERTAIN**
2/27/08	**3:00p**	**NY**	**Argentine-American**	**UNCERTAIN**
2/28/08	**9:00a**	**NY**	**U.S./Austrian**	**UNCERTAIN**
2/28/08	10:30a	Los Angeles, CA	Monica Danner	ON
2/28/08	12:00p	NY	Spain - U.S.	ON

Yours,
Ed Colbert

Edward T. Colbert
Kenyon & Kenyon LLP
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ecolbert@kenyon.com | www.kenyon.com

Exhibit F

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA *Movant,* v. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, *Non-Movant.*	United States Patent and Trademark Office Trademark Trial and Appeal Board Opposition No.: 91/156,321 Serial No.: 78/081,731

MOTION TO QUASH TRIAL TESTIMONY SUBPOENA DUCES TECUM

The Chamber of Commerce of the United States of America ("U.S. Chamber"), moves pursuant to Rule 45(c) of the Federal Rules of Civil Procedure, to quash the subpoena *duces tecum* that The United States Hispanic Chamber of Commerce ("USHCOC") has served on third party, the Swedish-American Chambers of Commerce USA, to prevent the production of the requested documents. Through the issued trial subpoena *duces tecum*, USHCOC improperly seeks to obtain document discovery during the middle of the trial phase of the administrative proceeding referenced in the subpoena and *more than eighteen months* after discovery in that proceeding closed. However, under the rules of the Trademark Trial and Appeal Board ("TTAB") of the U.S. Patent and Trademark Office (the body before which the referenced administrative proceeding is pending), discovery may not be sought and cannot be required after the close of discovery. Further, USHCOC has not sought the permission of the TTAB to reopen the discovery period, undoubtedly because it knew that such a request coming at this late date (and without good cause) would have been summarily denied.

The specific grounds on which Movant requests relief are set forth more fully in the accompanying memorandum and in the *Declaration of Erik C. Kane*, which is filed concurrently herewith. Given that the stated return date for the subpoena *duces tecum* is **February 22, 2008**, the U.S. Chamber respectfully requests expedited resolution of this motion.

Counsel for Movant hereby certifies that he conferred with counsel for the Non-Movant and attempted in good faith to resolve or narrow the issues raised by this motion. Non-Movant's counsel has indicated he will oppose this motion.

Respectfully submitted,

KENYON & KENYON LLP

Date: 2/13/08 By: Erik C. Kane

William M. Merone (VSB #38,861)
Erik C. Kane (VSB #68,294)
KENYON & KENYON LLP
1500 K Street, N.W.; Suite 700
Washington, D.C. 20005
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Fax: (202) 220 – 4201

Counsel for Movant, The Chamber of Commerce of the United States of America

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA *Movant,* v. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, *Non-Movant.*	United States Patent and Trademark Office Trademark Trial and Appeal Board Opposition No.: 91/156,321 Serial No.: 78/081,731

MEMORANDUM IN SUPPORT OF MOVANT'S MOTION TO QUASH TRIAL TESTIMONY SUBPOENA DUCES TECUM

The Chamber of Commerce of the United States of America ("U.S. Chamber"), submits this memorandum in support of its motion to quash the subpoena *duces tecum* issued by the United States Hispanic Chamber of Commerce Foundation ("USHCOC") on third party, Swedish-American Chambers of Commerce USA. Through the trial subpoena *duces tecum*, USHCOC improperly seeks third-party document discovery more than eighteen months after the close of discovery in the referenced administrative proceeding, and even though such actions are forbidden under the rules of the Trademark Trial and Appeal Board ("TTAB") of the U.S. Patent and Trademark Office, before which body the administrative proceeding is pending.

The broad categories of documents that USHCOC seeks from the third party could have been requested during the applicable discovery period, or, if necessary, USHCOC could have petitioned the TTAB to extend (or reopen) the discovery period so as to permit the desired discovery. USHCOC, however, did neither, and instead seeks last minute and disruptive discovery during the middle of the parties' trial testimony period (which is akin to seeking

discovery *during* an ongoing trial). Requesting that third party produce documents at this stage of the proceedings is improper, and also highly prejudicial. Accordingly, the U.S. Chamber respectfully requests that the Court quash the USHCOC's subpoena for document production.

BACKGROUND

The administrative proceeding referenced in the subpoena at issue in this motion is *The Chamber of Commerce of the United States of America v. United States Hispanic Chamber of Commerce Foundation*, Opposition No. 91-156231, which is pending before the Trademark Trial and Appeal Board ("TTAB") of the U.S. Patent and Trademark Office. The underlying dispute concerns the USHCOC's attempt to register a certain trademark in the Trademark Office.

The proceeding commenced on April 11, 2003, and discovery closed on June 1, 2006. (*See* Declaration of Erik C. Kane, ¶ 2 "*Kane Decl.*"). At present, the parties are in the middle of the trial phase known as the "testimony period." During the testimony period—much like in a regular trial—the parties call witnesses to testify on their behalf, with the witnesses' testimony being recorded and submitted in deposition form (rather than having witnesses testify live) .

The U.S. Chamber's testimony period closed on June 29, 2007 (*Kane Decl.* ¶ 3), which means that the U.S. Chamber, in effect, is done putting on its opening case. The USHCOC, as the "Defendant" (called the "Applicant" before the TTAB), is presently in the middle of its testimony period, which period is scheduled to close on February 28, 2008. (*Kane Decl.* ¶4).

On January 31, 2008, USHCOC provided the U.S. Chamber with three *Notices of Trial Depositions*, scheduling the trial depositions of three party (or party-controlled) witnesses for later this month (which was proper). On Friday, February 8, 2008, USHCOC then served ten subpoenas *ad testificandum* on various third parties, scheduling ten additional trial depositions

all for the last week of February (which is highly suspect).[1] However, in addition to those subpoenas *ad testificandum*, USHCOC also served ten subpoenas *duces tecum* through which its seeks document productions (which is improper), including the subpoena at issue here.[2] (*Kane Decl.* ¶5). The subpoena *duces tecum* calls for the Swedish-American Chambers of Commerce USA to produce a wide range of documents to counsel for USHCOC on February 22, 2008, which is before the appearance date for trial testimony noticed in the same subpoena. *Id.*

ARGUMENT

All proceedings before the Trademark Trial and Appeal Board are governed by the Lanham Act, 15 U.S.C. § 1051 et seq., and the administrative rules governing those proceedings may be found in Parts 2 and 7 of Title 37 of the Code of Federal Regulations ("the Trademark Rules"). While these procedural rules are based largely on the Federal Rules of Civil Procedure, they have been modified by the TTAB to take into account the particular administrative nature of the proceedings. *See Trademark Board Manual of Procedure* ("*TBMP*")[3], §101.01 (See Kane Decl. ¶6). As a result, the propriety of the requested discovery must be evaluated under the Trademark Rules, which also control in the event of any conflict with other rules. *See Chevron*

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[1] The USHCOC must put on all of its testimony by February 28, 2008, but yet waited until the very last moment before noticing the third party trial depositions. Thus, it is doubtful that the USHCOC will be able to complete all of the depositions by the close of trial given that the schedules of the third parties presumably are unknown. In fact, what seems to be happening is that the USHCOC intends to seek an *extension* of its trial period on the basis that it supposedly needs to "accommodate" the scheduling concerns of these third parties, even though USHCOC has already had *more than 6 months* to put on its case. Whether the TTAB would grant an extension is unknown.

[2] Applicant has additionally served nine other subpoenas *duces tecum* on third parties, with those subpoenas issuing from the U.S. District Court of the Southern District of New York, (5 subpoenas), and the U.S. District Court for the District of Columbia (4 subpoenas). The U.S. Chamber has filed motions to quash the subpoenas issued from those jurisdictions on the same grounds as presented here.

[3] The *Trademark Board Manual of Procedural* is the document in which the TTAB undertakes to "describe[] current practice and procedure under the applicable authority." *See TBMP*, Introduction.

U.S.A., Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844 (1984) ("We have long recognized that considerable weight should be accorded to an executive department's construction of a statutory scheme it is entrusted to administer, and the principle of deference to administrative interpretations."); *see also Meyer v. Holley,* 537 U.S. 280, 281 (2003) ("[T]he Court ordinarily defers to an administering agency's reasonable statutory interpretation.")

By way of the subpoena *duces tecum* at issue before the Court, the USHCOC seeks the production of broad categories of documents from the Swedish-American Chambers of Commerce USA. However, as discovery closed in this administrative proceeding more than eighteen months ago, and considering further that the Trademark Rules (even more so than the Federal Rules) do not permit discovery outside of the designated period, the subpoena is decidedly improper. Further, a trial testimony subpoena may not be used as a post-discovery discovery device. The subpoena should therefore be quashed and the Court should order that the documents not be produced.

I. The USHCOC Cannot Unilaterally Reopen the Discovery Period

The USHCOC is seeking the production of documents from various third parties even though the discovery period for the referenced administrative proceeding closed more thane eighteen months ago. The TTAB is very clear that discovery devices such as requests for production of documents can only be served and used during discovery. *See* TBMP, §403.01 ("The discovery devices ... are available for use only during the discovery period. A party has no obligation to respond to an untimely request for discovery") (footnote omitted); 37 C.F.R. § 2.120(a) (2008) ("Discovery depositions must be taken, and [written discovery requests] must be served, on or before the closing date of the discovery period as originally set or as reset."). Any

request to reopen the discovery period must be approved by the TTAB, and the request must be accompanied by a showing of "excusable neglect." TBMP, §509.01(b); *see also* 37 C.F.R. § 2.120(a)(2); *Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2d 1582 (TTAB 1997) (adopting analysis set forth in *Pioneer Investment Serv. Co. v. Brunswick Assoc. L.P.*, 507 U.S. 380 (1993)).

Under the present circumstances, the TTAB would unlikely grant a motion to reopen discovery. As noted previously, the parties are in the middle of their *trial testimony* period, with discovery having closed more than eighteen months ago. The TTAB has noted that mere delay in initiating discovery does not constitute good cause for even an *extension* of the discovery period, let alone reopening it. *See TBMP*, §403.04 ("mere delay in initiating discovery does not constitute good cause for an extension of the discovery period"); *see also id.*, §509.01(b) (noting that "the third *Pioneer* factor, i.e., 'the reason for the delay, including whether it was within the reasonable control of the movant,' may be deemed to be the most important of the ... factors" when ruling on whether to reopen discovery in a particular case). Here, the USHCOC has not only waited more than eighteen months after the close of discovery to seek documents from ten separate third parties, it has served these requests *in the middle* of its testimony period, and after the U.S. Chamber's testimony period has already closed. The U.S. Chamber would therefore be severely prejudiced by this belated discovery (and the USHCOC subsequent reliance on them during any third party trial deposition the following week) as the U.S. Chamber would not have the opportunity to conduct any follow up discovery about the material, either for purposes of cross-examination of the third-party witnesses or to develop a rebuttal case.

II. Trial Subpoenas Cannot be Used to Seek Discovery

As noted above, it is improper for the USHCOC to request that third parties produce documents for use in a TTAB administrative proceeding after the close of the discovery period. Indeed, at least one court has specifically address this point, holding that the use of subpoena *duces tecum* to seek discovery beyond the discovery period set by the TTAB is improper. *Li and Fung Ltd. v. L.W. Loyd Co.*, 143 U.S.P.Q. 117, 118-119 (E. D. Tenn. 1964) ("Rule 2.120 of the Trademark Rules of Practice [37 C.F.R. §2.120] requires the taking of discovery evidence prior to the taking of any testimony for the trial. If the subpoena duces tecum calls for documents and papers that are for discovery, then this part of the motion to quash is good.").

Moreover, the fact that USHCOC has included its document requests along with a subpoena *ad testificandum* does not provide it with cover for conducting a fishing expedition to find new material to shore up its case in the wake of the U.S. Chamber putting on its own trial evidence. Courts from around the country have overwhelmingly held that issuing a subpoena *duces tecum* as an adjunct to a subpoena *ad testificandum* is presumptively improper, except in the limited circumstance where there is a need for the witness to bring to trial a specific, known document. *See, e.g., Dodson v. CBS Broad.*, 2005 U.S. Dist. LEXIS 30126, 4-5 (S.D.N.Y. 2005) ("Dodson's subpoena clearly seeks discovery, as is apparent from his having the subpoena returnable to his address in New Jersey at the present time, instead of to Judge Wood's courtroom at the time of trial. Moreover, the scope of the request is broad and clearly is designed for discovery, not last-minute trial needs (such as for originals of documents where copies were produced in discovery and there is a need for the original at trial).") (*See Kane Decl.* ¶ 7); *see also McKay v. Triborough Bridge and Tunnel Authority,* 2007 WL 3275918, *2, n.1 (S.D.N.Y. 2007) (quashing subpoena where "the scope of the request is broad and clearly is designed for

discovery, not last-minute trial needs") (citations omitted) (*See Kane Decl.* ¶8); *BASF Corp. v. Old World Trading Co.*, 1992 WL 24076 at *2 (N.D. Ill. 1992) (Trial subpoenas "may not be used as a means to engage in further discovery. . . . Here, discovery has been closed for almost eleven months, and the court will not allow the parties to engage in discovery through trial subpoenas.") (See Kane Decl. ¶9); *Mortgage Info. Servs., Inc. v. Kitchens*, 210 F.R.D. 562, 566-68 & n.2 (W.D.N.C. 2002) ("After reviewing the relevant case law on both sides of this issue, the Court adopts the rule followed by the majority of jurisdictions and holds that a Rule 45 subpoena does in fact constitute discovery."); *Puritan Inv. Corp. v. ASLL Corp.*, 1997 WL 793569 at *1 (E. D. Pa. 1997) ("Rule 45 "trial subpoenas [duces tecum] may not be used ... as means to engage in discovery after the discovery deadline has passed.") (*See* Kane Decl. ¶10); *Dreyer v. GACS Inc.*, 204 F.R.D. 120, 122-23 (N.D. Ind. 2001) ("Rule 45 subpoenas constitute 'discovery' within the meaning of Rules 26 and 34. . . . This Court ... does not believe that a party should be allowed to employ a subpoena after a discovery deadline to obtain materials from third parties that could have been produced during discovery.") (quotation omitted); *Grant v. Otis Elevator Co.*, 199 F.R.D. 673, 675 (N.D. Okla. 2001) ("Litigants may not use the subpoena power of the court to conduct discovery after the discovery deadline."); *Alper v. United States*, 190 F.R.D. 281, 283-84 (D. Mass. 2000); *Rice v. United States*, 164 F.R.D. 556, 558 & n.1 (N.D. Okla. 1995).

As in *Dodson* and other cases, here the USHCOC is seeking the production of documents *prior* to the date that the witness is scheduled to appear to testify. Moreover, the scope of the document requests are clearly designed to obtain discovery, as opposed to satisfying a legitimate, last-minute trial related need as might relate to a specific, known document. *See e.g. Kane Decl.*, ¶5, Ex. F, Schedule B, Req. No. 5 (commanding that the third party produce, among other things,

all "[l]etters, emails, or the like reflecting communications with the U.S. Chamber of Commerce, membership in the U.S. Chamber of Commerce, or any agreements or licenses with the U.S. Chamber of Commerce"). In fact, at no point during discovery did the USHCOC *ever* seek any documents from the subpoenaed third party, thus foreclosing any argument that the subpoena *duces tecum* is actually for some specific, trial-related need, rather than merely being for general discovery request (which, of course, is also evident by the earlier return date).

CONCLUSION

For the reasons discussed above, the U.S. Chamber requests that the subpoena *duces tecum* that the USHCOC issued on the Swedish-American Chambers of Commerce USA should be quashed, and that a protective order should be entered prohibiting the production of requested documents.

Respectfully submitted,

KENYON & KENYON LLP

Date: 2/13/08 By: Erik C. Kane

William M. Merone (VSB #38,861)
Erik C. Kane (VSB #68,294)
KENYON & KENYON LLP
1500 K Street, N.W.; Suite 700
Washington, D.C. 20005
Tel.: (202) 220 – 4200
Fax: (202) 220 – 4201

Counsel for Movant, The Chamber of Commerce of the United States of America

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA *Movant,* v. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, *Non-Movant.*	United States Patent and Trademark Office Trademark Trial and Appeal Board Opposition No.: 91/156,321 Serial No.: 78/081,731

ERIK C. KANE, under penalty of perjury, declares as follows:

1. I am an associate with the law firm of Kenyon & Kenyon LLP, which represents Movant The Chamber of Commerce of the United States of America ("U.S. Chamber") in this matter. I make this declaration in support of U.S. Chamber's Motion to Quash Trial Testimony Subpoena Duces Tecum of The Swedish-American Chamber of Commerce USA.

2. Attached hereto as Exhibit A is a true and correct copy of a April 26, 2006 scheduling order issued by the Trademark Trial and Appeal Board ("TTAB").

3. Attached hereto as Exhibits B-C are true and correct copies of the parties' April 16, 2007 stipulated motion to reset trial dates and the TTAB's April 18, 2007 order entering the stipulated motion.

4. Attached hereto as Exhibits D-E are true and correct copies of the parties' October 1, 2007 stipulated motion for an extension of time and the TTAB's October 2, 2007 order entering the stipulated motion.

5. Attached hereto as Exhibit F is a third party subpoena issued by the United States Hispanic Chamber of Commerce Foundation on February 8, 2008.

6. Attached hereto as Exhibit G are true and correct copies of various sections of the Trademark Trial and Appeal Board Trademark Board Manual of Procedure.

7. Attached hereto as Exhibit H is a true and correct copy of *Dodson v. CBS Broad.*, 2005 U.S. Dist. LEXIS 30126 (S.D.N.Y. 2005).

8. Attached hereto as Exhibit I is a true and correct copy of *McKay v. Triborough Bridge and Tunnel Authority,* 2007 WL 3275918 (S.D.N.Y. 2007).

9. Attached hereto as Exhibit J is a true and correct copy of *BASF Corp. v. Old World Trading Co.*, 1992 WL 24076 (N.D. Ill. 1992).

10. Attached hereto as Exhibit K is a true and correct copy of *Puritan Inv. Corp. v. ASLL Corp.*, 1997 WL 793569 (E. D. Pa. 1997).

Dated: February 13, 2008

Erik C. Kane

Erik C. Kane

Exhibit A

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: April 26, 2006

Opposition No. 91156321

THE CHAMBER OF COMMERCE OF THE UNITED STATES

v.

United States Hispanic Chamber of Commerce Foundation

Linda Skoro, Interlocutory Attorney

This case comes up on opposer's motion to suspend and/or extend the trial dates filed on March 13, 2006. Applicant has opposed the motion.[1]

The grounds for its motion are to "afford the parties time to continue ongoing settlement negotiations...". Applicant's objection is that "opposer has made very little effort to advance the settlement of this matter in the last

[1] Applicant requests that the motion be denied because opposer failed to serve a copy of the motion on applicant and also that the motion not be considered filed on the last day of the discovery period, i.e., March 13, 2006, due to the failure of service. However, the Board issued an order on April 21, 2006 requiring opposer to provide a service copy to applicant, and now that applicant has actual notice and has responded to the motion, opposer's motion is being considered as filed on March 13, 2006. Opposer is reminded, however, of its obligation to serve copies of electronic filings on opposing counsel and to have the certificate of service contained in the electronic filing.

six months", the length of time this matter has been pending, *i.e.*, three years, and a desire to move the matter forward.

Because applicant states that settlement negotiations are going nowhere and because this is the eighth request for further delay, opposer's motion to suspend is hereby denied, but its motion to extend the trial periods[2] is hereby granted as set forth below.

Discovery period to close:	**6/1/ 2006**
30-day testimony period for party in position of plaintiff to close:	**8/30/2006**
30-day testimony period for party in position of defendant to close:	**10/29/2006**
15-day rebuttal testimony period to close:	**12/13/2006**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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[2] Applicant opposed opposer's request for a sixty-day extenxion, but because opposer's motion was filed on the last day of the discovery period, and the Board is just now addressing the motion, a thirty-day extension is being granted.

Exhibit B

Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA135576**

Filing date: **04/16/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91156321
Party	Plaintiff The Chamber of Commerce of the United States of America The Chamber of Commerce of the United States of America
Correspondence Address	William M. Merone Kenyon & Kenyon 1500 K Street N.W., Suite 700 Washington, DC 20005 UNITED STATES ekane@kenyon.com
Submission	Stipulated/Consent Motion to Extend
Filer's Name	William M. Merone
Filer's e-mail	tmdocketdc@kenyon.com
Signature	/William M. Merone/
Date	04/16/2007
Attachments	Motion to Reset Trial Dates (USHCOC).pdf (4 pages)(26191 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA *Opposer,* v. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, *Applicant.*	Opposition No.: 91/156,321 Serial No.: 78/081,731

MOTION ON CONSENT TO RESET TRIAL DATES

Pursuant to TBMP Section 509 and Trademark Rule 2.121, Opposer, The Chamber of Commerce of the United States of America, requests that the trial dates for this proceeding be reset in accordance with the schedule below. Opposer is making this request to accommodate the scheduling conflicts of counsel for Applicant, United States Hispanic Chamber of Commerce Foundation, which has consented to this request.

Testimony in the present case opened on March 20th, 2007. On April 2nd, Opposer served on Applicant its *Notices of Taking Testimonial Depositions*, setting testimony in this case for April 18th – 20th. Shortly thereafter, Applicant asserted that it would be unable to attend the scheduled testimony, and that it also could not attend any depositions in May because of a conflicting trial schedule. Applicant thus requested that Opposer reschedule its testimony depositions for some time beginning the first week of June. To accommodate that request, Opposer has agreed to reschedule its testimony dates, which will now run from June 8th – 28th.

Opposer thus submits that it has shown good cause for extending the testimony period, and requests on consent that its testimony period be extended up through and including **Friday, June 29th**. Specifically, the parties consent to the following schedule:

30-day testimony period for plaintiff in the opposition to close:	6/29/2007
30-day testimony period for defendant in the Opposition and as plaintiff in the counterclaim to close:	8/29/2007
30-day testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close:	10/29/2007
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	12/15/2007
Briefs shall be due as follows: [See Trademark rule 2.128(a)(2)].	
Brief for plaintiff in the opposition shall be due:	2/15/2008
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	3/17/2008
Brief for defendant in the counterclaim and its Reply brief (if any) as plaintiff in the opposition shall be due:	4/17/2008
Reply brief (if any) for plaintiff in the counterclaim shall be due:	5/2/2008

Opposer submits that the proposed schedule modifications are necessary to permit the orderly presentation of evidence in this case and are being made to accommodate the parties' scheduling concerns, and not for the purpose of delaying these proceedings. However, should the Board not agree to the above proposed schedule, Opposer requests in

the alternative that the Board grant at least a thirty (30) day extension of time to permit Opposer to reschedule the trial depositions previously noticed.

Respectfully submitted,

Date: April 16, 2006

/William M. Merone/
Edward T. Colbert
William M. Merone
KENYON & KENYON
1500 K Street, N.W.; Suite 700
Washington, D.C. 20005
Tel.: (202) 220 - 4200
Fax: (202) 220 - 4201

Counsel for Opposer, The Chamber of Commerce of the United States of America

CERTIFICATE OF SERVICE

I hereby certify that the required number of copies of the foregoing *Motion On Consent To Reset Trial Dates* was served on the parties or counsel on the date and as indicated below:

By First-Class Mail (Postage Prepaid)
and Facsimile: (310) 312 – 4224

Jill M. Pietrini
Andrew Eliseev
MANATT PHELPS & PHILLIPS, LLP
11355 W. Olympic Boulevard
Los Angeles, CA 90064-1614

Date: April 16, 2007

/William M. Merone/
Edward T. Colbert
William M. Merone
Erik C. Kane
KENYON & KENYON LLP
1500 K Street, N.W.; Suite 700
Washington, D.C. 20005
Tel.: (202) 220 – 4200
Fax: (202) 220 – 4201

Counsel for Opposer, The Chamber of Commerce of the United States of America

Exhibit C

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: April 18, 2007

Opposition No. 91156321

The Chamber of Commerce of the United States of America

v.

United States Hispanic Chamber of Commerce Foundation

Linda Skoro, Interlocutory Attorney

On March 15, 2007, the Board denied applicant's motion to compel discovery, finding that applicant had not made the requisite good faith effort to resolve the discovery dispute, and further that opposer's discovery responses were sufficient. Applicant has filed a timely request for reconsideration to which opposer has objected.

Motions for reconsideration, as set forth in 37 C.F.R. § 2.127(b), provide an opportunity for a party to point out any error the Board may have made in considering the matter initially. It is not to be a reargument of the points presented in its original motion. In this case, applicant continues to argue that it is prejudiced by opposer's failure to supplement its discovery responses.

Upon careful consideration of applicant's arguments on reconsideration, we are not persuaded that there was any

error in our decision. Applicant appears to misunderstand its burden in a motion to compel. Opposer stated its objections to certain discovery requests. Applicant disagreed with those objections, but did not inform opposer as to why it disagreed with opposer's objections. It is not opposer's burden to justify its objections if applicant has not stated grounds why it challenges the objections. Generally the Board looks for the parties' good faith effort to work out any discovery disputes through an exchange of correspondence designed to resolve the disagreement. That clearly was not present before the motion to compel was filed.

Accordingly, the request for reconsideration is denied. The parties' consented motion to reset dates, filed April 16, 2007, is hereby granted. Dates are set as provided in that motion.

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Exhibit D

Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA165803**

Filing date: **10/01/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91156321
Party	Defendant United States Hispanic Chamber of Commerce Foundation
Correspondence Address	Jill M. Pietrini Manatt Phelps & Phillips, LLP 11355 W. Olympic Boulevard Los Angeles, CA 90064-1614 UNITED STATES mdanner@manatt.com
Submission	Stipulated/Consent Motion to Extend
Filer's Name	Jill M. Pietrini
Filer's e-mail	mdanner@manatt.com
Signature	/jillpietrini/
Date	10/01/2007
Attachments	Amended Stipulated Motion for Extension.pdf (3 pages)(60142 bytes)

Docket No. 27206-060

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Matter of Application No. 78/081,731 *for the mark* UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA, Opposer, vs. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, Applicant.	Opposition No. 91-156231 **AMENDED STIPULATED MOTION FOR EXTENSION OF TIME**
And Related Counterclaims	

Commissioner for Trademarks
ATTN: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria,VA 22313-1451

Pursuant to 37 C.F.R. § 2.121(d) and TBMP § 501, Applicant United States Hispanic Chamber of Commerce Foundation ("Applicant"), by and through its counsel, and Opposer The Chamber of Commerce of the United States of America ("Opposer"), by and through its counsel, hereby jointly move for and stipulate to an extension of 5 months of the schedule set in this action. **This Amended Stipulated Motion for Extension of Time is being submitted instead and in place of the Stipulated Motion for Extension of Time dated September 12, 2007** because the dates for the counterclaims were incorrect.

This extension is necessary to allow the parties to avoid multiple scheduling conflicts in September 2007 and the upcoming months of October 2007 through January 2008. Specifically, Applicant set testimony depositions for three witnesses in mid-September. Notices for those depositions were served on Opposer by mail on August 29, 2007. Opposer objected to the notices because it did not receive them until September 5, 2007. Opposer's counsel was also unavailable on two of the days selected for the depositions. Applicant's witnesses were not available the later part of September because of the annual convention for United States Hispanic Chamber of Commerce which Applicant's witness planned to attend. Finally, Applicant's counsel is scheduled to be out of the country from October 5, 2007 to October 25, 2007. Upon her return, Opposer's counsel is scheduled for trial in another matter in December out of state.

Applicant and Opposer agreed to this extension via e-mail on September 7, 2007. Accordingly, Applicant and Opposer stipulate to the following schedule for the remaining testimony and trial dates in this action:

Testimony period for defendant/counterclaimant to close	February 28, 2008
Rebuttal testimony period for plaintiff/counterdefendant to close	April 28, 2008
Rebuttal testimony period for counterclaimant to close	June 14, 2008
Plaintiff's brief is due	August 13, 2008
Defendant/counterclaimant's brief is due	September 12, 2008
Plaintiff's reply brief/Counterdefendant's brief is due	October 12, 2008
Counterclaimant's reply brief is due	October 27, 2008

Respectfully submitted,

Date: October 1, 2007

/s/ Jill Pietrini
Jill Pietrini
Andrew Eliseev
MANATT, PHELPS & PHILLIPS, LLP
11355 W. Olympic Blvd., 10th Floor
Los Angeles, California 90064
(310) 312-4000

Attorneys for Applicant

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. § 2.195(a) on this 1st day of October, 2007.

/s/ Monica Danner
Monica Danner

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Erik Kane, Esq., Kenyon & Kenyon, 1500 K Street, N.W., Suite 700, Washington, DC 20005, on this 1st day of October, 2007.

/s/ Monica Danner
Monica Danner

41161664.1

Exhibit E

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: October 2, 2007

Opposition No. 91156321

The Chamber of Commerce of the United States of America

v.

United States Hispanic Chamber of Commerce Foundation

Angela Campbell, Paralegal Specialist:

Applicant's stipulated motion for extension of time filed September 17, 2007 and amended stipulated motion for extension of time filed October 1, 2007 to extend trial dates, including dates for the counterclaim, are granted. Trademark Rule 2.127(a).

Trial dates, including dates for the counterclaim, are reset in accordance with applicant's motion.

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint

of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm

Exhibit F

Docket No. 27206-060

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re Application Serial No. 78/081,731 for U.S. HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA, Opposer, vs. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, Applicant.	Opposition No. 91-156,321 **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S NOTICE OF TAKING TESTIMONY DEPOSITION OF SWEDISH – AMERICAN CHAMBERS OF COMMERCE USA**

TO OPPOSER AND ITS ATTORNEYS OF RECORD:

Pursuant to Trademark Rule 2.123(c) and the Federal Rules of Civil Procedure, Applicant United States Hispanic Chamber of Commerce Foundation ("Applicant"), will take the testimony deposition, by oral examination, of Swedish – American Chambers of Commerce USA on Tuesday, February 26, 2008, beginning at 12:00 p.m. A copy of the subpoena for the witness is attached.

Applicant will take the deposition at the following address:

Manatt, Phelps & Phillips, LLP
One Metro Center
700 12th Street, N.W.
Suite 1100
Washington, D.C. 20005

The deposition will be conducted before an officer authorized to administer oaths and will be recorded by stenographic methods.

Opposer is invited to attend and cross-examine.

MANATT, PHELPS & PHILLIPS, LLP

Dated: February 8, 2008

By: Andrew Eliseev
Jill M. Pietrini
Andrew Eliseev
Attorneys for Applicant United States Hispanic Chamber of Commerce Foundation

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION'S NOTICE OF TAKING TESTIMONY DEPOSITION OF SWEDISH – AMERICAN CHAMBERS OF COMMERCE USA** has been served upon the attorney for Opposer by facsimile and depositing a copy thereof in an envelope addressed to:

Erik C. Kane
KENYON & KENYON
1500 K Street, N.W., Suite 700
Washington, DC 20005
Fax: (202) 220-4201

on this 8th day of February, 2008.

Betty Lee

41204992.1

AO88 (Rev. 12/07) Subpoena in a Civil Case

Issued by the

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF VIRGINIA

The Chamber of Commerce of the United States of America,
Opposer,

V.

United States Hispanic Chamber of Commerce Foundation,
Applicant.

SUBPOENA IN A CIVIL CASE

Case Number:[1] U.S. Patent and Trademark Office, Trademark Trial and Appeal Board Case No. 91-156,321

TO: The Swedish - American Chambers of Commerce USA
1403 King Street
Alexandria, VA 22314

☐ YOU ARE COMMANDED to appear in the United States District court at the place, date, and time specified below to testify in the above case.

PLACE OF TESTIMONY	COURTROOM
	DATE AND TIME

☒ YOU ARE COMMANDED to appear at the place, date, and time specified below to testify at the taking of a deposition in the above case.

PLACE OF DEPOSITION	DATE AND TIME
Manatt, Phelps & Phillips, LLP; One Metro Center, 700 12th Street, N.W., Suite 1100, Washington, D.C. 20005. See Schedule A attached hereto.	February 26, 2008, 12:00 p.m.

☒ YOU ARE COMMANDED to produce and permit inspection and copying of the following documents or objects at the place, date, and time specified below (list documents or objects):

See Schedule B attached hereto.

PLACE	DATE AND TIME
Manatt, Phelps & Phillips, LLP; One Metro Center, 700 12th Street, N.W., Suite 1100, Washington, D.C. 20005.	February 22, 2008, 1:00 p.m.

☐ YOU ARE COMMANDED to permit inspection of the following premises at the date and time specified below.

PREMISES	DATE AND TIME

Any organization not a party to this suit that is subpoenaed for the taking of a deposition shall designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may set forth, for each person designated, the matters on which the person will testify. Federal Rule of Civil Procedure 30(b)(6).

ISSUING OFFICER'S SIGNATURE AND TITLE (INDICATE IF ATTORNEY FOR PLAINTIFF OR DEFENDANT)	DATE
Andrew Eliseev — Attorneys for Applicant	February 8, 2008

ISSUING OFFICER'S NAME, ADDRESS AND PHONE NUMBER
Andrew Eliseev
Manatt, Phelps & Phillips, LLP; 11355 W. Olympic Boulevard, Los Angeles, CA 90064;
Telephone: (310) 312-4384

(See Federal Rule of Civil Procedure 45 (c), (d), and (e), on next page)

[1] If action is pending in district other than district of issuance, state district under case number.

PROOF OF SERVICE

DATE PLACE

SERVED

SERVED ON (PRINT NAME) MANNER OF SERVICE

SERVED BY (PRINT NAME) TITLE

DECLARATION OF SERVER

I declare under penalty of perjury under the laws of the United States of America that the foregoing information contained in the Proof of Service is true and correct.

Executed on _____
DATE

_____
SIGNATURE OF SERVER

_____
ADDRESS OF SERVER

Federal Rule of Civil Procedure 45 (c), (d), and (e), as amended on December 1, 2007:

(c) PROTECTING A PERSON SUBJECT TO A SUBPOENA.

(1) Avoiding Undue Burden or Expense; Sanctions. A party or attorney responsible for issuing and serving a subpoena must take reasonable steps to avoid imposing undue burden or expense on a person subject to the subpoena. The issuing court must enforce this duty and impose an appropriate sanction — which may include lost earnings and reasonable attorney's fees — on a party or attorney who fails to comply.

(2) Command to Produce Materials or Permit Inspection.

(A) Appearance Not Required. A person commanded to produce documents, electronically stored information, or tangible things, or to permit the inspection of premises, need not appear in person at the place of production or inspection unless also commanded to appear for a deposition, hearing, or trial.

(B) Objections. A person commanded to produce documents or tangible things or to permit inspection may serve on the party or attorney designated in the subpoena a written objection to inspecting, copying, testing or sampling any or all of the materials or to inspecting the premises — or to producing electronically stored information in the form or forms requested. The objection must be served before the earlier of the time specified for compliance or 14 days after the subpoena is served. If an objection is made, the following rules apply:

(i) At any time, on notice to the commanded person, the serving party may move the issuing court for an order compelling production or inspection.

(ii) These acts may be required only as directed in the order, and the order must protect a person who is neither a party nor a party's officer from significant expense resulting from compliance.

(3) Quashing or Modifying a Subpoena.

(A) When Required. On timely motion, the issuing court must quash or modify a subpoena that:

(i) fails to allow a reasonable time to comply;

(ii) requires a person who is neither a party nor a party's officer to travel more than 100 miles from where that person resides, is employed, or regularly transacts business in person — except that, subject to Rule 45(c)(3)(B)(iii), the person may be commanded to attend a trial by traveling from any such place within the state where the trial is held;

(iii) requires disclosure of privileged or other protected matter, if no exception or waiver applies; or

(iv) subjects a person to undue burden.

(B) When Permitted. To protect a person subject to or affected by a subpoena, the issuing court may, on motion, quash or modify the subpoena if it requires:

(i) disclosing a trade secret or other confidential research, development, or commercial information;

(ii) disclosing an unretained expert's opinion or information that does not describe specific occurrences in dispute and results from the expert's study that was not requested by a party; or

(iii) a person who is neither a party nor a party's officer to incur substantial expense to travel more than 100 miles to attend trial

(C) Specifying Conditions as an Alternative. In the circumstances described in Rule 45(c)(3)(B), the court may, instead of quashing or modifying a subpoena, order appearance or production under specified conditions if the serving party:

(i) shows a substantial need for the testimony or material that cannot be otherwise met without undue hardship; and

(ii) ensures that the subpoenaed person will be reasonably compensated.

(d) DUTIES IN RESPONDING TO A SUBPOENA.

(1) Producing Documents or Electronically Stored Information. These procedures apply to producing documents or electronically stored information:

(A) Documents. A person responding to a subpoena to produce documents must produce them as they are kept in the ordinary course of business or must organize and label them to correspond to the categories in the demand.

(B) Form for Producing Electronically Stored Information Not Specified. If a subpoena does not specify a form for producing electronically stored information, the person responding must produce it in a form or forms in which it is ordinarily maintained or in a reasonably usable form or forms.

(C) Electronically Stored Information Produced in Only One Form. The person responding need not produce the same electronically stored information in more than one form.

(D) Inaccessible Electronically Stored Information. The person responding need not provide discovery of electronically stored information from sources that the person identifies as not reasonably accessible because of undue burden or cost. On motion to compel discovery or for a protective order, the person responding must show that the information is not reasonably accessible because of undue burden or cost. If that showing is made, the court may nonetheless order discovery from such sources if the requesting party shows good cause, considering the limitations of Rule 26(b)(2)(C). The court may specify conditions for the discovery.

(2) Claiming Privilege or Protection.

(A) Information Withheld. A person withholding subpoenaed information under a claim that it is privileged or subject to protection as trial-preparation material must:

(i) expressly make the claim; and

(ii) describe the nature of the withheld documents, communications, or tangible things in a manner that, without revealing information itself privileged or protected, will enable the parties to assess the claim.

(B) Information Produced. If information produced in response to a subpoena is subject to a claim of privilege or of protection as trial-preparation material, the person making the claim may notify any party that received the information of the claim and the basis for it. After being notified, a party must promptly return, sequester, or destroy the specified information and any copies it has; must not use or disclose the information until the claim is resolved; must take reasonable steps to retrieve the information if the party disclosed it before being notified; and may promptly present the information to the court under seal for a determination of the claim. The person who produced the information must preserve the information until the claim is resolved.

(e) CONTEMPT.

The issuing court may hold in contempt a person who, having been served, fails without adequate excuse to obey the subpoena. A nonparty's failure to obey must be excused if the subpoena purports to require the nonparty to attend or produce at a place outside the limits of Rule 45(c)(3)(A)(ii).

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SCHEDULE A

1. The date of the Swedish-American Chambers of Commerce USA's ("SACC") first use of the trademark THE SWEDISH-AMERICAN CHAMBER OF COMMERCE, or any other mark or name including CHAMBER OF COMMERCE (the "SACC Marks").

2. The types of products and services that the SACC offers, sells or sold under, or bearing or promoted as or under, the SACC Marks (the "SACC Products and Services").

3. The SACC's marketing and/or advertising of the SACC Products and Services.

4. The number and type of customers of the SACC Products and Services and/or the number of members of the SACC.

5. The amount spent by the SACC to advertise or promote the SACC Products and Services from inception to the present.

6. Publicity relating to the SACC Products and Services, including but not limited to, reviews, features, or mentions of the SACC Products and Services in any medium and all press releases relating to any SACC Products and Services.

7. Any instances of confusion between the SACC (or the SACC Products and Services) and the U.S. Chamber of Commerce (or its products and services).

8. Any instances of confusion between the SACC (or the SACC Products and Services) and the U.S. Hispanic Chamber of Commerce (or its products and services).

9. Allegations of trademark infringement or any challenges to the use or registration of the SACC Marks, if any, by the U.S. Chamber of Commerce against the SACC.

SCHEDULE B

1. Representative samples of documents and things reflecting the advertising, promotion, offering for sale, and/or sale of SACC's Products and Services, including but not limited to, catalogs, advertisements, website pages, brochures, tradeshow materials, *etc.*

2. Representative samples of documents and things reflecting the total number of SACC members from inception to the present.

3. Representative documents and things reflecting any publicity relating to SACC's Products and Services, including but not limited to, press releases, articles, stories, or the like featuring, mentioning, or reviewing SACC's Products and Services.

4. Representative samples of documents and things reflecting the geographic scope of SACC's use of the SACC Marks.

5. Letters, emails, or the like reflecting communications with the U.S. Chamber of Commerce, membership in the U.S. Chamber of Commerce, or any agreements or licenses with the U.S. Chamber of Commerce.

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Exhibit G

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP)

Second Edition
June 2003

Revision 1
March 2004

United States Patent and Trademark Office

101 Applicable Authority

101.01 Statute and Rules of Practice

All proceedings before the Trademark Trial and Appeal Board ("TTAB" or "Board") are governed by the Lanham Trademark Act of 1946, as amended, ("Act of 1946" or "Act"), 15 U.S.C. § 1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Parts 2 and 7 of Title 37 of the Code of Federal Regulations ("CFR"); the rules pertaining to assignments in trademark cases, which may be found in Parts 3 and 7 of 37 CFR; and the rules relating to representation of others before the United States Patent and Trademark Office which may be found in Part 10 of 37 CFR. The United States Patent and Trademark Office ("USPTO" or "Office") rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings.[1]

A copy of Title 37 of the CFR may be obtained at a nominal cost from the U.S. Government Printing Office. Title 37 of the CFR may also be found on the Internet at the Government Printing Office web site at: www.access.gpo.gov/nara/cfr or at the USPTO web site at: www.uspto.gov.

Information regarding proposed and final rule changes to Title 37 is also posted on the Office web site at www.uspto.gov.

101.02 Federal Rules

Inter partes proceedings before the Board are also governed by the Federal Rules of Civil Procedure ("Fed. R. Civ. P."), except as otherwise provided in the Trademark Rules of Practice, and "wherever applicable and appropriate";[2] and by the Federal Rules of Evidence ("Fed. R. Evid.").[3]

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[1] *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

[2] *See* 37 CFR § 2.116(a).

[3] *See* 37 CFR §§ 2.116(a), 2.120(a), and 2.122(a); *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1753 n.3 (Fed. Cir. 1998); and *Cerveceria India Inc. v. Cervecevia Centroamericana, S.A.*, 10 USPQ2d 1064 (TTAB 1989), *aff'd, Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1311 (Fed. Cir. 1989) (In applying the burden of proof provisions of Fed. R. Evid. 301, the court stated "[t]he Federal Rules of Evidence generally apply to TTAB proceedings.").

of its case and that it is unable, without undue hardship, to obtain the substantial equivalent of the materials by other means.[18]

403 Timing of Discovery

403.01 In General

37 CFR § 2.120(a) ... The Trademark Trial and Appeal Board will specify the opening and closing dates for the taking of discovery. The trial order setting these dates will be mailed with the notice of institution of the proceeding. The discovery period will be set for a period of 180 days. The parties may stipulate to a shortening of the discovery period. The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset. Discovery depositions must be taken, and interrogatories, requests for production of documents and things, and requests for admission must be served, on or before the closing date of the discovery period as originally set or as reset.
...

When a timely opposition or petition to cancel in proper form has been filed, and the required fee has been submitted (or at the time described in 37 CFR § 2.92 for an interference and 37 CFR § 2.99(c) for a concurrent use proceeding); the Board sends out a notice advising the parties of the institution of the proceeding.[19] The notice includes a trial order setting the opening and closing dates for the discovery period and assigning each party's time for taking testimony.[20] The date set for the close of discovery is 180 days after the opening of discovery.

The discovery devices, namely, discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, are available for use only during the discovery period.[21] A party has no obligation to respond to an untimely request for discovery.

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[18] *See, for example*, Fed. R. Civ. P. 26(b)(3) and (b)(5); *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975); and *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975). *See also Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc.*, 185 USPQ 432 (TTAB 1975); *Amerace Corp. v. USM Corp.*, 183 USPQ 506 (TTAB 1974); and *Goodyear Tire & Rubber Co. v. Uniroyal, Inc.*, 183 USPQ 372 (TTAB 1974) and TBMP § 412 (Protective Orders).

[19] *See* 37 CFR §§ 2.105 and 2.113; and TBMP §§ 310, 1003 and 1106.

[20] *See* 37 CFR §§ 2.120(a) and 2.121(a).

[21] *See Smith International, Inc. v. Olin Corp.*, 201 USPQ 250, 251 (TTAB 1978) (although a specific time period is not provided in Rule 34, it is implicit that utilization thereof is limited to the discovery period) and *Rhone-Poulenc Industries v. Gulf Oil Corp.*, 198 USPQ 372, 373 (TTAB 1978).

under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending request for discovery.[26]

A party which fails to respond to a request for discovery during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits.[27] Objections going to the merits of a discovery request include claims that the information sought by the request is irrelevant, overly broad, unduly vague and ambiguous, burdensome and oppressive, or not likely to lead to the discovery of admissible evidence.[28] In contrast, objections based on claims of privilege or confidentiality or attorney work product do not go to the merits of the request, but instead to a characteristic of the information sought.[29]

403.04 Extensions of Discovery Period and/or Time to Respond to Discovery Requests

37 CFR § 2.120(a) ... The discovery period may be extended upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. If a motion for an extension is denied, the discovery period may remain as originally set or as reset.

* * * *

... The time to respond [to interrogatories, requests for production of documents and things, and requests for admission] may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery

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[26] *See* Fed. R. Civ. P. 26(d); *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1070 (TTAB 1990) and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 632 (TTAB 1986).

[27] *See No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000) (stating that the Board has great discretion in determining whether such forfeiture should be found); *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448, 449 (TTAB 1979) (excusable neglect not shown where opposer was out of the country and, upon return, failed to ascertain that responses were due); and *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691, 691 (TTAB 1975) (waived right to object by refusing to respond to interrogatories, claiming that they served "no useful purpose"). *See also Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1303 (TTAB 1987) (right to object not waived where although discovery responses were late, there was some confusion regarding time to answer); and *MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 USPQ 952, 953 (TTAB 1979) (party seeking discovery is required to make good faith effort to determine why no response has been made before coming to Board with motion to compel).

[28] *See No Fear Inc. v. Rule*, *supra* at 1554.

[29] *See No Fear Inc. v. Rule*, *supra* at 1554 (party will generally not be found to have waived the right to make these objections).

and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

37 CFR § 2.121(a)(1) ... The resetting of the closing date for discovery will result in the rescheduling of the testimony periods without action by any party.

* * * *

(d) When parties stipulate to the rescheduling of testimony periods or to the rescheduling of the closing date for discovery and the rescheduling of testimony periods, a stipulation presented in the form used in a trial order, signed by the parties, or a motion in said form signed by one party and including as statement that every other party has agreed thereto, shall be submitted to the Board.

The closing date of the discovery period may be extended by stipulation of the parties approved by the Board, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. An extension of the closing date for discovery will result in a corresponding extension of the testimony periods without action by any party.[30] A stipulation or consented motion to extend discovery and trial dates must be filed with the Board and should be presented in the form used in a trial order.[31]

Mere delay in initiating discovery does not constitute good cause for an extension of the discovery period.[32] Thus, a party which waits until the waning days of the discovery period to serve interrogatories, requests for production of documents and things, and/or requests for admission will not be heard to complain, when it receives responses thereto after the close of the discovery period, that it needs an extension of the discovery period in order to take "follow-up" discovery.[33]

At the same time, a party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, rob its adversary of the opportunity to take "follow-up" discovery. Such a delay or improper response constitutes good cause for an extension of the

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[30] *See* 37 CFR § 2.121(a)(1). *For information concerning stipulations to extend, see* TBMP § 501.03. *For information concerning motions to extend, see* TBMP § 509.

[31] *See* 37 CFR § 2.121(d).

[32] *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (no reason given why discovery was not taken during the time allowed); and Janet E. Rice, *TIPS FROM THE TTAB: The Timing of Discovery*, 68 Trademark Rep. 581 (1978).

[33] *See American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1316 n. 4 (TTAB 1992).

discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party) so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion.[34]

The time for responding to a request for discovery may be extended or reopened by stipulation of the parties, or on motion (pursuant to Fed. R. Civ. P. 6(b)) granted by the Board, or by order of the Board. However, an extension of a party's time to respond to an outstanding request for discovery will not result in an automatic corresponding extension of the discovery and/or testimony periods.[35] Such periods will be rescheduled only on stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board.

A stipulation to extend or reopen only the time for responding to a request for discovery (that is, not to extend or reopen also the closing date for the discovery period and/or testimony periods) does not have to be filed with the Board. However, to avoid any misunderstanding between the parties as to the existence and terms of such a stipulation, it is recommended that the stipulation be reduced to writing, even if it is not filed with the Board.

403.05 Need for Early Initiation of Discovery

403.05(a) To Allow Time for "Follow-up" Discovery

If a party wishes to have an opportunity to take "follow-up" discovery after it receives responses to its initial requests for discovery, it must serve its initial requests early in the discovery period, so that when it receives responses thereto, it will have time to prepare and serve additional discovery requests prior to the expiration of the discovery period.[36]

403.05(b) To Facilitate Introduction of Produced Documents

37 CFR § 2.120(j)(3)(ii) A party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).

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[34] *See Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990) and *Neville Chemical Co. v. Lubrizol Corp.*, 184 USPQ 689 (TTAB 1975).

[35] *See* 37 CFR §§ 2.120(a) and 2.121(a); and *PolyJohn Enterprises Corp.* v. *1-800-TOILETS, Inc.*, 61 USPQ2d 1860, 1861 (TTAB 2002) (mistaken belief that resetting time to respond to discovery also extended discovery and testimony periods did not constitute excusable neglect to reopen).

[36] *See* TBMP § 403.04 (Extensions of Discovery and Time to Respond).

If a motion to extend the time for taking action is denied, the time for taking such action may remain as previously set.[145]

While the time for filing a brief in response to a motion for summary judgment may be extended, the time for filing, in lieu thereof, a motion for discovery under Fed. R. Civ. P. 56(f) will not be extended.[146]

509.01(b) Motions to Reopen Time

509.01(b)(1) In General

Where the time for taking required action, as originally set or as previously reset, has expired, a party desiring to take the required action must file a motion to reopen the time for taking that action. The movant must show that its failure to act during the time previously allotted therefor was the result of excusable neglect. *See* Fed. R. Civ. P. 6(b).

The analysis to be used in determining whether a party has shown excusable neglect was set forth by the Supreme Court in *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). These cases hold that the excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith.[147]

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[145] *See, e.g.*, Trademark Rules 2.120(a) (discovery period); 2.121(a)(1) (testimony period); 2.127(a) (time for responding to a motion); and 2.127(e)(1) (time for responding to a summary judgment motion). *See also Fairline Boats plc v. New Howmar Boats Corp., supra* at 1479; *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co., supra*; *Luemme Inc. v. D.B. Plus Inc., supra;* and *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc., supra* at 1544 (petitioner's testimony period consequently expired where motion to extend testimony period was denied and dates were left as originally set).

Compare C.H. Stuart Inc. v. Carolina Closet, Inc., 213 USPQ 506, 507(TTAB 1980) (three-day testimony period for opposer reset "putting opposer in the same position it would have been in had no motion to compel been filed."). *In addition, see Notice of Final Rulemaking*, published in the Federal Register on September 9, 1998 at 63 FR 48081, specifically, comments and responses published in the notice at 48091, 1214 TMOG at 149.

[146] *See* TBMP § 528.06 (Request for Discovery to Respond to Summary Judgment).

[147] *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership, supra* at 395 and *Pumpkin Ltd. v. The Seed Corps, supra* at 1586. *See also* cases cited throughout this section and in TBMP §§ 534.02 regarding motions to dismiss under 37 CFR § 2.132, and 544 regarding motions for relief from final judgment.

The "prejudice to the nonmovant" contemplated under the first *Pioneer* factor must be more than the mere inconvenience and delay caused by the movant's previous failure to take timely action, and more than the nonmovant's loss of any tactical advantage which it otherwise would enjoy as a result of the movant's delay or omission. Rather, "prejudice to the nonmovant" is prejudice to the nonmovant's ability to litigate the case, e.g., where the movant's delay has resulted in a loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant.[148]

It has been held that the third *Pioneer* factor, i.e., "the reason for the delay, including whether it was within the reasonable control of the movant," may be deemed to be the most important of the *Pioneer* factors in a particular case.[149] Additionally, although many excusable neglect decisions which were issued prior to the Board's 1997 *Pumpkin* decision may no longer be controlling under the somewhat more flexible excusable neglect standard set out in *Pioneer* and *Pumpkin* (e.g., decisions holding that a failure to act due to counsel's docketing errors is, *per se*, not the result of excusable neglect), they nonetheless may be directly relevant to the Board's analysis under the third *Pioneer* excusable neglect factor.[150]

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[148] *See Pumpkin Ltd. v. The Seed Corps, supra* at 1587, citing *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997) and *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990).

[149] *See Pumpkin Ltd. v. The Seed Corps, supra* at n.7 and cases cited therein. *See also Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) (counsel's press of other business, docketing errors and misreading of relevant rule are circumstances wholly within counsel's control); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369 (TTAB 2000) (failed to provide specific reasons for former counsel's inaction); *HKG Industries Inc. v. Perma-Pipe Inc.*, 49 USPQ2d 1156, 1158 (TTAB 1998) (failed to provide evidence linking the reason for the delay with the expiration of movant's testimony period); and *Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858 (TTAB 1998) (failure to timely move to extend testimony period was due to counsel's oversight and mere existence of settlement negotiations did not justify party's inaction or delay).

[150] *See Pumpkin Ltd. v. The Seed Corps., supra* at 1586-87 and at n.8. Such pre-*Pioneer* cases include, *e.g.*, *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1712 (Fed. Cir. 1991) (no excusable neglect where plaintiff's counsel unreasonably relied on defendant's counsel to sign and file plaintiff's proposed stipulated motion to extend trial dates); *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (defendant's desire to take follow-up discovery and its uncertainty regarding status of plaintiff's pending motion to strike affirmative defenses did not excuse respondent's neglect in failing to file timely motion to extend discovery); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064, 2065 (TTAB 1990) (no excusable neglect where defendant's failure to timely respond to certain discovery requests was due to defendant's oversight or lack of care in reading discovery requests); *Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619 (TTAB 1986) (no excusable neglect where defendant's failure to timely respond to summary judgment motion was due to counsel's press of other litigation); and *Coach House Restaurant, Inc. v. Coach and Six Restaurants, Inc.*, 223 USPQ 176 (TTAB 1984) (same).

For additional cases involving the excusable neglect standard, see TBMP §§ 534 (Motion for Judgment for Plaintiff's Failure to Prove Case) *and* 544 (Motion for Relief from Final Judgment).

A party moving to reopen its time to take required action must set forth with particularity the detailed facts upon which its excusable neglect claim is based; mere conclusory statements are insufficient.[151]

In addition, for purposes of making the excusable neglect determination, it is irrelevant that the failure to timely take the required action was the result of the party's counsel's neglect and not the neglect of the party itself. Under our system of representative litigation, a party must be held accountable for the acts and omissions of its chosen counsel.[152]

509.01(b)(2) To Introduce Newly Discovered Evidence

If a party files a motion to reopen its testimony period to introduce newly discovered evidence, the moving party must show not only that the proposed evidence has been newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence.[153] However, even if a sufficient showing of due diligence has been made, the Board will not automatically reopen a party's testimony period for introduction of the new evidence. The Board must also consider such factors as the nature and purpose of the evidence sought to be brought in, the stage of the proceeding, and prejudice to the nonmoving party.[154]

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[151] *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc., supra* (no specific reasons for former counsel's inaction); *HKG Industries Inc. v. Perma-Pipe Inc., supra* (no factual details as to the date of counsel's death in relation to plaintiff's testimony period or as to why other lawyers in deceased counsel's firm could not have assumed responsibility for the case).

[152] *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership, supra* at 396 (citing *Link v. Wabash R. Co.*, 370 U.S. 626 (1962) and *United States v. Boyle*, 469 U.S. 241 (1985)); *Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc., supra*; *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300 (TTAB 1999); and *Pumpkin Ltd. v. The Seed Corps., supra* at 1586. *Cf. Netcore Technologies, Inc. v. Firstwave Technologies, Inc.*, ___ USPQ2d ___, 2001 WL 243440 (TTAB 2001) (attorney's unwarranted and untimely request to withdraw from representation of party may not be used as subterfuge to obtain a reopening of time to which the party is not otherwise entitled).

[153] *See, for example, Rowell Laboratories, Inc. v. Canada Packers Inc.*, 215 USPQ 523, 529 n.2 (TTAB 1982) (improper to attempt to introduce newly discovered evidence by way of rebuttal testimony rather than moving to reopen testimony period). *See also Oxford Pendaflex Corp. v. Roladex Corp.*, 204 USPQ 249 (TTAB 1979); *Wilson Sporting Goods Co. v. Northwestern Golf Co.*, 169 USPQ 510 (TTAB 1971); *United States Plywood Corp. v. Modiglass Fibers, Inc.*, 125 USPQ 144 (TTAB 1960); *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354 (TTAB 1984); *Tektronix, Inc. v. Daktronix, Inc.*, 187 USPQ 588 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); and *Chemetron Corp. v. Self-Organizing Systems, Inc.*, 166 USPQ 495 (TTAB 1970).

[154] *See Harjo v. Pro-Football, Inc.*, 45 USPQ2d 1789, 1790 (TTAB 1998) (newly discovered evidence was cumulative and redundant and did not have significant probative value to justify further delay of case) *citing*

Exhibit H

GARY W. DODSON, Plaintiff, -against- CBS BROADCASTING INC., et al., Defendants.

02 Civ. 9270 (KMW) (AJP)

UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

2005 U.S. Dist. LEXIS 30126

November 29, 2005, Decided
November 29, 2005, Filed

CORE TERMS: discovery, subpoena, contempt, deadline, subpoena duces tecum, pretrial, returnable

COUNSEL: [*1] Gary W. Dodson, Plaintiff, Pro se, Clark, NJ.

For CBS Broadcasting Inc., Charles Fagan, Tony DiGiovanni, Tony Pettiti, Mike Kentranakus, Defendants: Bettina Barasch Plevan, Howard Zachary Robbins, Proskauer Rose LLP, New York, NY; Thomas Martin Mullins, Jr, Sabin, Bermant & gould, New York, NY.

JUDGES: Andrew J. Peck, United States Chief Magistrate Judge.

OPINION BY: Andrew J. Peck

OPINION

OPINION AND ORDER

ANDREW J. PECK, United States Chief Magistrate Judge:

Presently before the Court is plaintiff Dodson's "Motion for Contempt & Court Order to Enforce Court Issued Subpoena." (Dkt. No. 82.) The motion is *DENIED* in all respects.

FACTS

Discovery in this case ended in late 2003, and in June 2004 I recommended that defendants' summary judgment motion should be granted in part and denied in part. *Dodson* v. *CBS*, 02 Civ. 9270, 2004 WL 1336231 (S.D.N.Y. June 15, 2004) (Peck, M.J.). Judge Wood affirmed my Report and Recommendation on August 31, 2004. (Dkt. No. 55.) The parties thereafter were to file their Pretrial Order, and the case is trial ready, although no trial date has yet been set.

On or about October 5, 2005, Dodson served a subpoena [*2] *duces tecum* on Bettina Plevan, counsel of record for defendants, returnable at Dodson's home in New Jersey, seeking 10 categories of documents.

On or about October 18, 2005, defendants objected to the subpoena.

On or about November 7, 2005, Dodson filed the instant motion for contempt and to enforce the subpoena (Dkt. No. 82), and on November 22, 2005, defendants filed their opposition papers (Dkt. Nos. 84-85).

ANALYSIS

Dodson's motion is procedurally defective in at least two ways: (a) He did not request a pre-motion conference, as required by Judge Wood's rules (Judge Wood's Individual Practices P2.A; *see also* S.D.N.Y. Local Civil Rule 37.2); and (b) The motion is not accompanied by a Memorandum of Law, as required by S.D.N.Y. Local Civil Rule 7.1.

Furthermore, even aside from the procedural defects, Dodson's motion lacks merit.

Contempt is not available since defendants responded to the subpoena by serving objections. *See* Fed. R. Civ. P. 45(c)(2)(B). When objections to a subpoena have been made, the correct procedure is a motion to compel, not a motion for contempt. *Id.*

As to the portion of Dodson's motion [*3] that seeks to compel compliance with the subpoena: Discovery closed long ago. Dodson's subpoena clearly seeks discovery, as is apparent from his having the subpoena returnable to his address in New Jersey at the present time, instead of to Judge Wood's courtroom at the time of trial. Moreover, the scope of the request is broad and clearly is designed for discovery, not last-minute trial needs (such as for originals of documents where copies were produced in discovery and there is a need for the original at trial). While Rule 45 can be used to subpoena documents to be introduced at trial as trial exhibits, the need to do so should be limited because of the liberal federal pretrial discovery rules. Dodson here had ample discovery.

Rule 45 "trial subpoenas [*duces tecum*] may not be used, however, as means to engage in discovery after the discovery deadline has passed." *Puritan Inv. Corp.* v. *ASLL Corp.*, No. Civ. A. 97-1580, 1997 WL 793569 at *1 (E.D. Pa. Dec. 9, 1997) (& cases cited therein); *accord, e.g.*, 9 *Moore's Federal Practice*, § 45.02 (Matthew Bender 3d ed. 2005) ("Several courts have concluded that after the discovery [*4] deadline a party may not use a subpoena to obtain materials from third parties that could have been produced during discovery.") (citing cases); *Playboy Enter. Int'l Inc.* v. *OnLine Entm't, Inc.*, No. 00-Civ.-6618, 2003 WL 1567120 at *1-2 (E.D.N.Y. Mar. 13, 2003); *Mortgage Info. Servs., Inc.* v. *Kitchens*, 210 F.R.D. 562, 566-68 & n.2 (W.D.N.C. 2002) ("After reviewing the relevant case law on both sides of this issue, the Court adopts the rule followed by the majority of jurisdictions and holds that a Rule 45 subpoena does in fact constitute discovery.") (citing cases & authorities); *Dreyer* v. *GACS Inc.*, 204 F.R.D. 120, 122-23 (N.D. Ind. 2001) ("Rule 45 subpoenas constitute 'discovery' within the meaning of Rules 26 and 34. . . . This Court, like *Rice*, does not believe 'that a party should be allowed to employ a subpoena after a discovery deadline to obtain materials from third parties that could have been produced during discovery.'"); *Grant* v. *Otis Elevator Co.*, 199 F.R.D. 673, 675 (N.D. Okla. 2001) ("Litigants may not use the subpoena power of the court to conduct discovery after the discovery deadline. [*5] "); *Alper* v. *United States*, 190 F.R.D. 281, 283-84 (D. Mass. 2000); *Rice* v. *United States*, 164 F.R.D. 556, 558 & n.1 (N.D. Okla. 1995); *BASF Corp.* v. *Old World Trading Co.*, No. 86 C 5602, 1992 WL 24076 at *2 (N.D. Ill. Feb. 4, 1992) (Trial subpoenas "may not be used as a means to engage in further discovery. . . . Here, discovery has been closed for almost eleven months, and the court will not allow the parties to engage in discovery through trial subpoenas. Furthermore, the court's policy of requiring parties to submit a pretrial order detailing those documents which it may use at trial is rendered nugatory if a trial subpoena may issue demanding documents not previously produced or identified."); *Stockwell* v. *Am. Allsafe Co.*, No. CIV-84-1179, 1986 WL 13941 at *1 (W.D.N.Y. Dec. 9, 1986); *Windsor Commc'ns Group, Inc.* v. *Price Waterhouse*, No. Civ. A 85-4119, 1986 WL 9888 at *1 (E.D. Pa. Sept. 8, 1986); *Pitter* v. *American Express Co.*, 82 Civ. 7451, 1984 WL 1272 at *6 (S.D.N.Y. Nov. 27, 1984); *United States* v. *Watchmakers of Switzerland Info. Ctr. Inc.*, 27 F.R.D. 513, 515 (S.D.N.Y. 1961). [*6]

Here, it is clear from the scope of Dodson's subpoena (and its return time and place) that it is for discovery purposes. As such, it is quashed and Dodson's motion is *DENIED.*

CONCLUSION

For the reasons set forth above, Dodson's motion for contempt and to enforce the subpoena *duces tecum* (Dkt. No. 82) is *DENIED.*

SO ORDERED.

Dated: New York, New York

November 29, 2005

Andrew J. Peck

United States Chief Magistrate Judge

Exhibit I

C
Only the Westlaw citation is currently available.

United States District Court,
S.D. New York.
Maurice McKAY, Plaintiff,
v.
TRIBOROUGH BRIDGE AND TUNNEL AUTHORITY et al, Defendants.
No. 05 Civ. 8936(RJS).

Nov. 5, 2007.

MEMORANDUM AND ORDER
RICHARD J. SULLIVAN, District Judge.

*1 Plaintiff Maurice McKay ("Plaintiff" or "McKay") brings this action against defendants Triborough Bridge and Tunnel Authority ("TBTA") and TBTA police officers Michael Chiaia, Michael Albano, Jose Vasquez, Clarence Whitaker, and Michael Zino (collectively "Defendants"), alleging violations of his civil rights pursuant to 42 U.S.C. § 1983. On or about August 3, 2007, approximately five months after the close of discovery in this case, Defendants served a subpoena on Plaintiff's employer, Metropolitan Transportation Authority ("MTA"), seeking Plaintiff's personnel, disciplinary, training, and other files maintained by the MTA (the "subpoena"). Pending before the Court is Plaintiff's motion to quash the subpoena and Defendants' letter in opposition, which the Court construes as a motion to reopen discovery, requesting that the Court order the production of documents as identified in the subpoena. For the following reasons, Defendants' request to reopen discovery is denied.

A district court has broad discretion "to direct and manage the pre-trial discovery process." *Wills v. Amerada Hess Corp.*, 379 F.3d 32, 41 (2d Cir.2004). As part of that discovery process, Rule 16(b) of the Federal Rules of Civil Procedure requires district courts to enter scheduling orders that limit the parties' time to complete discovery. Fed. R. Civ. Pro. 16(b)(3). The order "shall not be modified except upon a showing of good cause" and only by leave of the district judge. *Id.*; 6A Charles Alan Wright, Arthur R. Miller, and Mary Kay Kane, *Federal Practice and Procedure* § 1522.1 (2d ed.1990); *Grunga v. Ford Motor Co.*, No. 03 Civ. 7643(GEL), 2007 WL 2398806, at *1,2 (S.D.N.Y. Aug. 17, 2007) (noting that discovery is governed by the scheduling order and "may not be conducted after the close of discovery absent good cause to modify that order"). A party seeking relief from the discovery schedule, including the reopening of discovery when discovery has closed, must make an application to the Court demonstrating why good cause exists to modify the schedule. *Gray v. Town of Darien*, 927 F.2d 69, 74 (2d Cir.1991). Whether good cause exists "depends on the diligence of the moving party." *Grochowski v. Phoenix Const.*, 318 F.3d 80, 86 (2d Cir.2003); Fed.R.Civ.P. 16 Advisory Committee's Note (party seeking modification much show that the deadline could not "reasonably be met despite the diligence of the party seeking" modification); Wright, Miller, and Kane, *supra* § 1522.1; *see also Filkins v. City of New York*, No. 06 Civ.2095(CPS)(JO), 2007 WL 2713340, at *5 (E.D.N.Y. Sept. 13, 2007) (noting that, in assessing good cause, the Court should consider several factors, including "the diligence *vel non* of the party requesting an extension, bad faith *vel non* of the party opposing such extension, the phase of the litigation and prior knowledge of and notice to the parties") (internal citations and quotations omitted).

*2 In addition, district courts have held that parties may not issue subpoenas "as a means to engage in discovery after the discovery deadline has passed." *Dodson v. CBS Broad. Inc.*, No. 02 Civ. 9270(KMW)(AJP), 2005 U.S. Dist. LEXIS 30126, at *3-4 (S.D.N.Y. Nov. 29, 2005) (collecting cases); *Ellis v. City of New York*, 243 F.R.D. 109, 112 (S.D.N.Y.2007); *Playboy Enters. Int'l Inc. v. On Line Entm't, Inc.*, No. 00 Civ. 6618(RJD), 2003 WL 1567120, at *1 (E.D.N.Y. Mar. 13, 2003) (granting motion to quash where "plaintiffs took it upon themselves to serve subpoenas, without prior

application to the Court, months after discovery closed, little more than a month before trial, upon a non-party from whom discovery was never before sought."); *Stockwell v. American Allsafe Co.*, No. CIV-84-1179E, 1986 WL 13941, at *1 (W.D.N.Y. Dec. 9, 1986) (granting a motion to quash a subpoena as untimely where the subpoena sought employment records and was not served until approximately eight months after the close of discovery).

Defendants here concede that the subpoena was issued after the close of discovery, and that the requests in the subpoena, at least with regard to the request for pay records, "should have been conducted during the discovery phase." (Letter to the Court from Suzanne M. Halbardier, Esq. dated October 30, 2007 ("Pl.Opp.") at 2-3.) Nevertheless, Defendants assert that the Court should, in its discretion, direct MTA to respond to the subpoena because it seeks records that "will be trial exhibits" and "go to the reasonableness of the plaintiff's conduct." (*Id.* at 2.) Defendants further contend that the subpoena seeks documents that the defense "realized were relevant" only after the parties engaged in a court-ordered mediation on June 28, 2007, where the defense "became concerned that Mr. McKay's training for his own job could be very relevant on the issue of the reasonableness of Mr. McKay's actions on the day of the altercation." (*Id.* at 2.)

This Court agrees with the district courts that have held that service of a Rule 45 trial subpoena after the close of discovery is improper. *See Dodson*, 2005 U.S. Dist. LEXIS 30126, at *3-4 (collecting cases). As an initial matter, Defendants failed to make an application to the Court, pursuant to Rule 16(b) and the Court's Individual Practices, [FN1] to reopen discovery prior to serving the subpoena on the MTA despite the fact that the subpoena clearly seeks discovery. [FN2] Instead of moving to reopen discovery, Defendants issued the subpoena to the MTA without regard to and in spite of the fact that discovery in the case closed in March 2007, approximately five months before the subpoena was served. As such, the Court will construe Defendants' opposition as a motion to reopen discovery for the limited purposes of serving the MTA subpoena.

FN1. The Individual Practices of the undersigned, like the Individual Practice of the Honorable Kenneth M. Karas, District Judge, to whom this case was assigned at the time the subpoena was issued, require that parties seeking to file a motion must first submit a pre-motion letter to the Court.

FN2. That this is a subpoena for discovery is evidenced by the fact that the subpoena is returnable to Defendants' counsel's law firm. *See Dodson*, 2005 U.S. Dist. LEXIS 30126, at *3. Here, as in *Dodson*, while the subpoena seeks the production of documents defendants *may* introduce as trial exhibits, "the scope of the request is broad and clearly is designed for discovery, not last-minute trial needs (such as for originals of documents where copies were produced in discovery and there is a need for the original at trial)." *Id.* at *3.

The Court finds that Defendants have not demonstrated that good cause exists to reopen discovery to permit service and enforcement of the subpoena. Defendants do not contend that any new information has come to light since the mediation; they merely state that they "realized" at the mediation that they were not in possession of certain documents and speculate that those documents, if they exist, "could be relevant" to the issue of the reasonableness of Plaintiff's actions. (Pl. Opp. at 3.) Because Defendants have not shown why they could not have come to this conclusion and sought the subpoena prior to the close of discovery, it cannot be said that Defendants were sufficiently "diligent" in conducting discovery so as to justify reopening discovery five months after the close of discovery. *See Grochowski*, 318 F.3d at 86. To the extent that Defendants made any previous requests for documents covered by the subpoena (*i.e.* pay records, *see* Pl. Opp. at 3) during the discovery period with which Plaintiff did not comply, the appropriate response would have been to make a motion to compel at that time. *See Playboy Enterprises*, 2003 WL 1567120, at *1; *Ellis*, 243 F.R.D. at 112.

*3 Finally, Defendants assert that the documents are not "discovery under Mr. McKay's custody and control" and that the MTA is prepared to produce the requested documents pending the resolution of this motion. (*Id.* at 2.) Given that the Court has denied Defendants' request to reopen discovery, any arguments pertaining to whether Plaintiff has standing to move to quash the subpoena or whether the third parties are willing to produce the requested documents are moot.

For the foregoing reasons, Defendants' motion to reopen discovery to permit service of the MTA subpoena is DENIED. The parties are directed to serve a copy of this order on the MTA.

SO ORDERED.

Slip Copy, 2007 WL 3275918 (S.D.N.Y.)

END OF DOCUMENT

Exhibit J

Not Reported in F.Supp., 1992 WL 24076 (N.D.Ill.)
(Cite as: Not Reported in F.Supp.)

H

BASF Corp. v. Old World Trading Co.
N.D.Ill.,1992.
Only the Westlaw citation is currently available.
United States District Court, N.D. Illinois, Eastern Division.
BASF CORPORATION, Plaintiff,
v.
The OLD WORLD TRADING COMPANY, Defendant.
No. 86 C 5602.

Feb. 4, 1992.

MEMORANDUM OPINION AND ORDER

LEINENWEBER, District Judge.

*1 The following Memorandum Opinion and Order disposes of three pretrial motions pending before the court.

1. Old World's Motion to Quash Trial Subpoenas

Defendant, The Old World Trading Company (" Old World"), now moves to quash all trial subpoenas served by plaintiff, BASF Corporation (" BASF"), requesting production of documents returnable before February 3, 1992. According to Old World, BASF has served a number of trial subpoenas requesting production of documents before the start of trial without first providing notice to Old World as required by Fed.R.Civ.P. 45. BASF responds that it has withdrawn all but two of the trial subpoenas which call for the production of documents before February 3, 1992. According to BASF, notice of those two subpoenas-served upon Dearborn Division of W.R. Grace and Olympic Oil-was sent to Old World prior to the document requests. BASF further states that documents were received from the University of Iowa pursuant to a subpoena, although BASF does not specify whether notice of that subpoena was given to Old World before it was issued.

The court finds that subpoenas served by BASF without prior notice to Old World requesting the production of documents prior to trial were served in violation of Fed.R.Civ.P. 45. The court, therefore, quashes all trial subpoenas issued without prior notice and requesting production before trial, and orders BASF to provide Old World immediately with copies of all documents received to date in response to such subpoenas.

2. Old World's *Motion in Limine* to Bar the Introduction of Documents Produced Pursuant to *Ex Parte* Deposition Notices and Subpoenas *Duces Tecum* Served By BASF

Old World moves to bar the introduction of documents produced pursuant to *ex parte* deposition notices and subpoenas *duces tecum.* Specifically, Old World seeks to bar BASF trial exhibits 206 through 210, labeled by BASF as " subpoena responses" or "group ex. subpoena responses." BASF responds that the exhibit list is in error and that the "documents in Exhibits 206 through 210 were produced voluntarily by the listed parties without resort to the use of subpoenas." BASF Resp. at 9.

Where a party seeks to obtain documents from a non-party through the use of the court's subpoena power, it must provide notice of that subpoena to all other parties. Fed.R.Civ.P. 45. Here, the court will take BASF at its word-that it did not serve subpoenas or notices of deposition to obtain the documents referenced in exhibits 206 through 210. However, should evidence surface that subpoenas or notices of deposition were issued by BASF without notice to all parties, the court will entertain a motion to bar the introduction of any and all

documents falling within the scope of subpoenas or notices of deposition so served. In addition, the court orders BASF immediately to provide Old World with all documents in exhibits 206 through 210.

3. Old World's Motion to Bar the Use of Documents Received Pursuant to Subpoenas Served After the Close of Discovery

*2 Old World moves to bar the use of documents received pursuant to subpoenas served after the close of discovery. BASF concedes that it has served numerous trial subpoenas pursuant to Rule 45(a)(2) for documents returnable on the first day of trial. Old World now argues that the subpoenas issued, if and to the extent they resemble the subpoena served upon Mair Oil, are being used improperly as a discovery tool. The court agrees.

Fact discovery in this case was closed on March 7, 1991. While trial subpoenas may be used to require those served to produce documents at trial for the purpose of memory refreshment or trial preparation, they may not be used as a means to engage in further discovery. *See Pitter v. American Express Co., et al,* 1984 WESTLAW 1272 (S.D.N.Y.1984) ("shotgun production demands ... [by way of trial subpoena] are an impermissible substitute for orderly pre-trial discovery"). BASF's reliance on *U.S. v. IBM,* 71 F.D.R. 88 (S.D.N.Y.1976) is misplaced. There, discovery was continuing through trial and the issue was simply whether the party serving the subpoena should have moved for an order of inspection after objections to the subpoena were made. Here, discovery has been closed for almost eleven months, and the court will not allow the parties to engage in discovery through trial subpoenas. Furthermore, the court's policy of requiring parties to submit a pretrial order detailing those documents which it may use at trial is rendered nugatory if a trial subpoena may issue demanding documents not previously produced or identified.

For the reasons stated herein, the court 1) prohibits BASF from introducing at trial any documents not identified on its exhibit list, 2) quashes any and all trial subpoenas issued by BASF which request the production of documents not identified on the exhibit list, and 3) bars BASF from adding to its trial exhibit list any documents obtained pursuant to subpoenas served after the close of discovery.

IT IS SO ORDERED.

N.D.Ill.,1992.
BASF Corp. v. Old World Trading Co.
Not Reported in F.Supp., 1992 WL 24076 (N.D.Ill.)

END OF DOCUMENT

Exhibit K

H

Puritan Inv. Corp. v. ASLL Corp.
E.D.Pa.,1997.
Only the Westlaw citation is currently available.
United States District Court, E.D. Pennsylvania.
PURITAN INV. CORP.
v.
ASLL CORP. and Eric Blumenfeld
No. Civ.A. 97-1580.

Dec. 9, 1997.

Richard T. Brown, Jr., Phila, PA, for Puritan Investment Corporation, plaintiff.
Michael S. Saltzman, Fineman & Bach, P.C., Phila, PA, for ASLL Corporation, defendant.
Michael S. Saltzman (See above), for Eric Blumenfeld, defendant.

MEMORANDUM ORDER

WALDMAN, J.

*1 Presently before the court are defendants' alternative Motions for a Protective Order and to Quash Plaintiff's Subpoenas and defendants' Motion in Limine. Defendants challenge trial subpoenas served upon them by plaintiff for the production of an array of business, tax and financial records for use by plaintiff in attempting to sustain its alter ego liability theory against Mr. Blumenfeld. Defendants also seek by their motion in limine to preclude "any evidence or testimony of plaintiff's ' alter ego' theory." The only reason proffered is that plaintiff has no such evidence.

Plaintiff is suing for trademark infringement arising from defendants' failure to make required payments under a licensing agreement involving the operation of a comedy club. The discovery deadline was October 22, 1997, providing over eighteen weeks to conduct discovery. Plaintiff never requested an extension of the discovery deadline. The case has just entered the trial pool.

On November 24, 1997, plaintiff served subpoenas upon defendants directing them to produce at trial the following documents:

all documents concerning ASLL Corporation and its relation to Eric Blumenfeld, including but not limited to any documents proposing or relating to its formation in January 1995 or thereabouts, the bank records of ASLL Corporation from its formation to the present, the minute book and any other corporate records of ASLL Corporation showing meetings, resolutions, or any other activity by the corporation, all insurance documents issued to ASLL Corporation (including but not limited to declaration pages and invoices and checks paid) all tax returns filed by ASLL Corporation, all financial statements (audited or otherwise) concerning ASLL Corporation, and all other documents (including checks, notes, contracts, etc.) concerning transactions between Eric Blumenfeld and ASLL Corporation.

Defendants argue with some force that plaintiff is attempting to circumvent the discovery deadline. Defendants also claim that because the requested documents are voluminous and not all readily at their disposal, production would necessarily delay the trial of this action.

Plaintiff represents that no party propounded formal discovery requests, but instead met in May of 1997 to exchange informal discovery and that defendants knew since this meeting that such records might be used in court to support plaintiff's alter ego theory. Plaintiff does not represent, however, that defendants agreed at the May 1997 meeting to produce all of these records during the discovery period.

Trial subpoenas may be used to secure documents at trial for the purpose of memory refreshment or trial preparation or to ensure the availability at trial of original documents previously

disclosed by discovery. *See,* e.g., *Rice v. United States,* 164 F.R.D. 556, 558 n. 1 (N.D.Okla.1995); *BASF Corp. v. Old World Trading Co.,* 1992 WL 24076, *2 (N.D.Ill. Feb.4, 1992).

Trial subpoenas may not be used, however, as means to engage in discovery after the discovery deadline has passed. *See BASF Corp.,* 1992 WL 24076 at *2. *See also Ghandi v. Police Dept. of Detroit,* 747 F.2d 338, 354-55 (6th Cir.1984) (trial subpoena duces tecum used to seek discovery just prior to trial properly quashed); *Hatchett v. United States,* 1997 WL 397730, *3 (E.D.Mich. Feb.28, 1997) (trial subpoena cannot be used to obtain belated discovery after discovery period has ended); *Pitter v. American Express Co.,* 1984 WL 1272, *5 (S.D.N.Y. Nov.27, 1984) ("shotgun" production demands through use of trial subpoenas are impermissible substitute for proper pre-trial discovery).

*2 There is absolutely no indication that plaintiff knows what information is contained in the documents it seeks or that they would support plaintiff's theory of its case. A trial subpoena is not an appropriate means of ascertaining facts or uncovering evidence. This should be done through discovery in the manner and time provided by the Federal Rules and court order.

Plaintiff does not explain why the desired records were not obtained through a proper Rule 34 document request before the discovery deadline. Plaintiff bears the burden of preparing its own case for trial. Any documents it wished to peruse which were not voluntarily disclosed should have been timely demanded through formal discovery procedures.

Plaintiff does not and credibly could not aver that it was unaware of the possible existence of the subpoenaed documents before the discovery deadline. *See McNerney v. Archer Daniels Midland Co.,* 164 F.R.D. 584, 588 (W.D.N.Y.1995) ("when a [party] ... is aware of the existence of documents before the discovery cutoff date and issues discovery requests including subpoenas after the discovery deadline has passed, then the subpoenas and discovery requests should be denied"). The documents plaintiff now seeks are standard records routinely maintained by corporations. Moreover, plaintiff's contention that defendants knew since the informal May 1997 meeting that such records might be used by plaintiff to support its alter ego theory shows that plaintiff itself was aware of the existence of such documents months before the close of discovery.

The only reasonable conclusion from the record presented is that plaintiff is attempting to use trial subpoenas improperly as a discovery device on the eve of trial. *See, Thompson v. Glenmede Trust Co.,* 1996 WL 529691, *1 (E.D.Pa. Sept.16, 1996) (unjust and burdensome to require party on eve of trial to produce documents pursuant to subpoena served after discovery deadline).

Thus, defendants' motion to quash will be granted. Because efficiency in the resolution of litigation should be balanced with the objective of resolving legal claims to the extent possible on the basis of complete and accurate information, the motion will be denied without prejudice to plaintiff promptly to seek a continuance and extension of discovery if it can show good cause therefor. *See* Fed.R.Civ.P. 16(b). Because an order to preclude a party from presenting evidence on the ground that the party has no such evidence is needless and meaningless, defendants' motion in limine will be denied.

ACCORDINGLY, this 9th day of December, 1997, **IT IS HEREBY ORDERED** that defendants' Motions for a Protective Order and to Quash Plaintiff's Subpoenas are **GRANTED** in that the trial subpoenas *duces tecum* issued to defendants are **QUASHED,** without prejudice to plaintiff promptly to seek a discovery extension upon a showing of good cause; and, **IT IS FURTHER ORDERED** that defendants' Motion in Limine is **DENIED.**

E.D.Pa.,1997.
Puritan Inv. Corp. v. ASLL Corp.
Not Reported in F.Supp., 1997 WL 793569 (E.D.Pa.)

END OF DOCUMENT

Exhibit G

C

In re Rum Marketing Intern., Ltd.
S.D.Fla.,2007.
Only the Westlaw citation is currently available.
United States District Court,S.D. Florida.
In re Subpoena Served on RUM MARKETING INTERNATIONAL, LTD.
Diageo Brands, B.V., Plaintiff/Opposer,
v.
Compania Licorera De Centroamerica, S.A., Defendant/Applicant.
No. 07-21466-MC.
Application Serial No. 76/177,628.
Opposition No. 91153874.

Sept. 14, 2007.

Pending in U.S. Patent and Trademark Office Before the Trademark Trial and Appeal Board.

Barry N. Greenberg, Fowler White Burnett, Miami, FL, for Plaintiff.

ORDER ON MOTION TO QUASH IN WHOLE OR IN PART, OR, IN THE ALTERNATIVE, FOR ENTRY OF A PROTECTIVE ORDER

EDWIN G. TORRES, United States Magistrate Judge.

***1** This matter is before the Court upon Compania Licorera De Centroamerica, S.A.'s ("Compania Licorera's") Motion to Quash in Whole or in Part, or, in the Alternative, For Entry of a Protective Order [D.E. 1, 2] in response to a third-party subpoena served by Diageo Brands, B.V. on an entity doing business in the Southern District of Florida, Rum Marketing International, Ltd. ("Rum Marketing"). The subpoena was issued in connection with a pending administrative proceeding before the U.S. Patent and Trademark Office, Trial and Appeal Board ("USPTO"). Upon review of the Motion, Diageo Brands's response in opposition, the Reply, and the record in this miscellaneous matter, the pending Motion is ripe for disposition pursuant to an Order from the District Judge referring the case to the Magistrate Judge assigned to this case.

I. BACKGROUND

Diageo Brands is the owner of a federally registered "Black Label" trademark used for aged, premium alcoholic spirits. It is currently involved in an adversary proceeding against Compania Licorera that is pending before the Trademark Trial and Appeal Board of the USPTO. That proceeding is currently ongoing before that administrative agency of the United States.

On May 24, 2007, Diageo Brands served a third party to that administrative proceeding, Rum Marketing, a Rule 30(b)(6) deposition subpoena duces tecum that noticed that entity for a corporate representative deposition on June 4, 2007. The subpoena sought deposition discovery and documents regarding Rum Marketing's activities related to Compania Licorera's application filed before the USPTO. The noticed date of the deposition fell on the last day of the discovery period provided for by the administrative board's rules governing the proceeding.

On June 1, 2007, Rum Marketing's counsel contacted counsel for Diageo Brands to advise that no representative of Rum Marketing knowledgeable on the topics set forth in the Rule 30(b)(6) deposition subpoena would be available to testify on the date noticed. Rum Marketing also objected to certain document requests included in the subpoena. On that same date, Rum Marketing's counsel served Diageo with objections to the document requests.

As a result, the deposition did not take place on June 4th. Diageo Brands contends that it was willing to reschedule the deposition to accommodate Rum Marketing's request. Nevertheless, on June 6, 2007, Compania Licorera filed the pending miscellaneous action in the Southern District of Florida through a motion to quash the subpoena or alternat-

ive motion for protective order. The motion argues that the service of the subpoena on Rum Marketing violated Rule 45 and this Court's local rules with regard to the amount of notice provided to the third party and Compania Licorera as to the date for the deposition. The motion also argues that the subpoena was untimely based upon the USPTO's discovery cutoff date in the administrative proceeding. Alternatively, Compania Licorera's motion requests entry of a protective order with respect to several document requests included in the subpoena that seek production of confidential trade secrets.

***2** Diageo Brands opposes the entry of either a motion to quash or motion for protective order. It argues that Compania Licorera has no standing to raise the arguments raised in the pending motion, as the third party Rum Marketing has not directly sought any relief from the subpoena. Furthermore, Diageo Brands argues that it indeed provided sufficient notice to Rum Marketing and that counsel failed to comply with the Court's Local Rules, as well as the USPTO's Rules, requiring pre-filing conferences before filing such motions.

II. ANALYSIS

Federal courts are courts of limited jurisdiction. We possess only the power strictly authorized by the Constitution and statute. *Kokkonen v. Guardian Life Ins. Co. of Am.*, 511 U.S. 375, 377, 114 S.Ct. 1673, 128 L.Ed.2d 391 (1994). The court's jurisdiction cannot be be expanded merely through judicial decree. *Id.* (citations omitted)."It is to be presumed that a cause lies outside this limited jurisdiction, and the burden of establishing the contrary rests upon the party asserting jurisdiction."*Id.* (internal citations omitted).

There is no basis alleged in the pending motion for the exercise of federal jurisdiction. The motion clearly implies, however, that jurisdiction exists because there is a pending administrative proceeding before the USPTO, from which a "subpoena" was issued under Rule 45 of the Federal Rules of Civil Procedure on a third party residing in the Southern District of Florida, and as would ordinarily occur in a case pending before the Court a party can seek judicial relief under Rule 45 and, more generally, Rule 26 of the Federal Rules.

That implied basis for jurisdiction treats this case as an ordinary miscellaneous action arising from a motion to quash a subpoena related to a proceeding pending before another district court. Under Rule 45(a) of the Federal Rules, without question, this Court would have jurisdiction to entertain a motion to quash a subpoena issued out of this District in an action pending before another District. But that is true only if there is a pending action before a federal court with federal subject matter jurisdiction. *See Olcott v. Delaware Flood Co.*, 76 F.3d 1538, 1552 (10th Cir.1996).

Here, however, there is no pending case before another federal court that has subject matter jurisdiction over the parties and the litigation. Consequently, there is no jurisdiction purely under the provisions of Rules 26 or 45 for counsel for Diageo Brands to issue a Rule 45 subpoena, nor any jurisdiction for counsel for Compania Licorera to move to quash that subpoena.

That conclusion then leads to Rule 81 of the Federal Rules. Subsection (a) of that Rule provides what proceedings "[t]hese rules" (obviously including Rules 26 and 45) are governed by the Rules. There is no provision in the Rule for applying Rule 45's provisions whenever a subpoena issued in connection with an administrative proceeding. To the contrary, Rule 81 only provides that the Federal Rules apply "to proceedings to compel the giving of testimony or production of documents in accordance with a subpoena issued by an officer or agency of the United States under any statute of the United States except as otherwise provided by statute or by rules of the district court or by order of the court in the proceedings."

***3** In cases involving proceedings before the USPTO, the applicable statute that triggers jurisdic-

tion to "compel the giving of testimony" is 35 U.S.C. § 24:

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent and Trademark Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office....

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify.

Indeed, the discovery rules of the USPTO expressly refer to this statute as the basis upon which a party can seek to compel the attendance of witnesses for deposition in matters pending before the agency. 37 C.F.R. § 2.120(b) ("Discovery deposition within the United States."). Significantly, the USPTO's rules also include a provision for adjudication of motions for protective order filed by parties to the proceeding, consistent with Rule 26(c) of the Federal Rules of Civil Procedure. *Id.* § 2.120(f).

This Court's jurisdiction is thus limited to the express provisions of Rule 81, 35 U.S.C. § 24, and in accordance with the discovery procedures contemplated by the USPTO's discovery rules. The Rule adopted in the Eleventh Circuit requires that the Court compel only that discovery contemplated by the USPTO's discovery rules and within the scope of discovery permitted by those rules. *See Brown v. Braddick,* 595 F.2d 961, 966 (5th Cir.1979) (adopting rules in First and Third Circuits); *see also United States v. Anaconda Co.,* 445 F.Supp. 486, 487-88 (D.D.C.1977) ("The court has but a limited role to play in the enforcement of administrative subpoenas. The scope of issues that can be litigated in an enforcement proceeding is narrow, because of the Government's interest in expeditious investigation to carry out its congressionally mandated duties.").

Given the limited nature of this Court's jurisdiction here, we must apply these principles strictly to the facts presented. Clearly, had a third-party witness refused to comply with the requirements of a properly served Rule 45 subpoena in a USPTO action, then this Court, as per Rule 81 and 35 U.S.C. § 24, would have jurisdiction to enforce that subpoena. The pending motion, of course, does not fall under that category.

Second, the converse also applies. A third-party witness served with a subpoena under Rule 45 in a USPTO action may seek relief from the Court that issued the subpoena to quash or modify the subpoena on any ground permissible under Rule 45. *See, e.g., Brown,* 595 F.2d at 966-68 (addressing merits of appeal from denial of motion to quash subpoenas issued under 35 U.S.C. § 24). And thus the normal procedures that apply to third party witnesses under Rule 45 would also be followed. The witness may simply serve objections to the subpoena and be excused from compliance pending disposition of a motion to compel, if filed before the Court that issued the subpoena. *See, e.g., Pamida, Inc. v. E.S. Originals, Inc.,* 283 F.3d 726, 732 (8th Cir.2002); *McCabe v. Ernst & Young LLP,* 221 F.R.D. 423 (D.N.J.2004). Or, the witness may affirmatively move to quash the subpoena under Rule 45(c)(3).*See, e.g., Nova Products, Inc. v. Kisma Video, Inc.,* 220 F.R.D. 238, 241 (S.D.N.Y.2004).

***4** In this case the third party witness served by the subpoena in question, Rum Marketing, did not move to quash the subpoena. At best, the correspondence or communications from its counsel to Diageo Brands's counsel could be deemed a Rule 45 objection, which would then have obligated Diageo Brands to move to compel and enforce its subpoena if the objections were not otherwise resolved between the parties.

Instead, the party to the USPTO proceeding filed a motion to quash or alternative motion for protective order. The reasons cited in the motion are the lack of notice to the subpoenaed party, lack of notice to the party, and attempted production of "confidential information." Even outside the scope of the limited jurisdiction available under section 24, it is well settled that a party to litigation cannot ordinarily file a motion to quash a subpoena before the jurisdiction that issued it. *Nova Products,* 220 F.R.D. at 241 (denying motion to quash filed by party); *Hertenstein v. Kimberly Home Health Care, Inc.,* 189 F.R.D. 620, 635 (D.Kan.1999) (same).

That principle is clearly true in cases under 35 U.S.C. § 24. As *Brown* held, a party has no standing to move to quash a subpoena issued under the jurisdiction afforded by that statute unless the party is in possession of the subpoenaed materials *and* has a personal right or privilege that should be enforced to prevent the third-party witness from violating that right or privilege. 595 F.2d at 967.

The pending motion does not satisfy either of these elements. There is no allegation that Compania Licorera has possession of the subpoenaed materials to confer standing upon it to move to quash the subpoena. Nor has it sufficiently shown that any privileged materials are in the third-party's possession. The only allegation in the motion is that the documents are "confidential." But that contention, without more, is not enough to give rise to standing.*Hertenstein,* 189 F.R.D. at 635.

Additionally, Rule 45 contemplates quashing or modifying a subpoena in response to the third-party's claim that a subpoena calls for disclosure of trade secret or confidential commercial information, not the party's "confidential" information. And only the subpoenaed third-party obviously should have standing to raise that objection. There are, of course, circumstances when the nature of the relationship between the party and the third-party could confer standing on the party, such as a bank account holder whose records are subpoenaed from the bank. No such argument is raised here that these entities were in a similar relationship.

Therefore, to the extent the third-party's confidential information was being sought through this subpoena, it was incumbent upon that third-party to serve its objections or file a motion to quash. The pending motion to quash, however, was not filed by that entity with standing to do so. And, the very narrow exception to the general rule has not been shown to apply under the circumstances involved here. Furthermore, other arguments raised in the motion are clearly not within the scope of a privilege or right that the party can raise. Rum Marketing's inability to respond to the subpoena given the time it was provided is clearly something that should only be raised by Rum Marketing.*See, e.g., Smith v. America Online, Inc.,* 2007 U.S. Dist. LEXIS 1655 (M.D.Fla. Jan. 9, 2007) (citing *Auto-Owners Ins. Co. v. Southeast Floating Docks, Inc.,* 231 F.R.D. 426, 249 (M.D.Fla.2005)). That also goes for the argument that the subpoena was overbroad.

***5** This conclusion is also buttressed by the fact that the applicable discovery procedures that govern this proceeding-that of the USPTO-clearly provide a mechanism by which the party to the proceeding can seek relief before the body that has plenary jurisdiction over the dispute. Subsection (f) of the USPTO's discovery regulations clearly allow Compania Licorera to file a motion for protective order. That could have been done here in conjunction with Rum Marketing's objection to the subpoena. Had that occurred, the USPTO could have addressed the substantive issues raised in that motion, and it would have been in a far better position to do so than this Court that has far less knowledge or involvement in the proceedings currently pending. Compania Licorera's failure to follow that procedure cannot be excused by this Court adjudicating a motion to quash that is not contemplated in Rule 81 or the governing statute that confers limited jurisdiction in this case. The general rule, that clearly should also govern this limited proceeding, is that the body that has plenary jurisdiction over

the litigation is the body empowered to grant protective orders to control the scope of discovery in the litigation. *See, e.g., GFL Advantage Fund, Ltd. v. Colkitt,* 216 F.R.D. 189 (D.D.C.2003).

Therefore, whether one looks at this matter as a lack of jurisdiction to grant the particular relief requested, or alternatively a basic lack of standing under Rule 45, the inevitable conclusion is that the relief requested should be Denied. The pending motion was not a motion filed by the subpoenaeing party to compel compliance, nor was it filed by the subpoenaed third party seeking relief from the burdens imposed upon that third party in responding to the subpoena. That denial is, of course, without prejudice to Compania Licorera pursuing this matter with the USPTO. Even at this date a protective order could certainly be obtained. But whether or not the subpoena here should be modified or whether the deposition should be rescheduled to accommodate Compania Licorera are matters that should only be addressed before the USPTO.[FN1]

> FN1. This analysis also applies to Diageo Brands. To the extent that the issues raised in this motion are not amicably resolved, Diageo Brands should respect Rum Marketing's objections and address these matters before the USPTO. Only then should Diageo Brands seek to compel compliance with its subpoena. Otherwise, the Judge that could be tasked to review a motion to compel by Diageo Brands could decide to transfer the case back to the USPTO. *See Goodyear Tire & Rubber Co. v. Kirk's Tire & Auto Servicecenter of Haverstraw, Inc.,* 211 F.R.D. 658, 660 (D.Kan.2003) (court that issues subpoena has discretion to transfer subpoena-related motions to district where action pending).

Finally, as the Court has disposed of the issues in the pending motion based upon the limited jurisdiction it has under 35 U.S.C. § 24, we will not address any other substantive arguments raised in the motion or in the opposition filed by Diageo Brands.

III. CONCLUSION

For the foregoing reasons, the Motion to Quash in Whole or in Part, or the Alternative Motion for Entry of a Protective Order [D.E. 1] is **DENIED** without prejudice to the resolution of any related disputes before the USPTO. Additionally, as all matters pending before the Court were referred and have now been adjudicated, there is no further basis for this matter to remain open. Accordingly, the Clerk of the Court is DIRECTED to close this case.

DONE AND ORDERED.

S.D.Fla.,2007.
In re Rum Marketing Intern., Ltd.
Slip Copy, 2007 WL 2702206 (S.D.Fla.)

END OF DOCUMENT

Exhibit H

Pietrini, Jill

From: Pietrini, Jill
Sent: Thursday, February 21, 2008 7:02 AM
To: 'Kane, Erik'
Cc: Eliseev, Andrew
Subject: RE: Transcripts for Rita Perlman

Erik:

We know that there are no errata sheets in TTAB cases, but you still have to provide us with notice of what changes were made. You can send us the corrected pages for each transcript that was changed, and each time that the transcript changed, e.g., changes between the 1st and 2nd versions, changes between the 2nd and 3rd versions. Thank you.

From: Kane, Erik [mailto:Ekane@kenyon.com]
Sent: Thursday, February 21, 2008 9:58 AM
To: Pietrini, Jill
Subject: RE: Transcripts for Rita Perlman

Jill,

There are no erratta sheets as the Board does not allow them. I am however, checking with the court reporter to see if they have some way (maybe through their text files) of creating a redline to show the changes. If they can, I would be happy to send them to you, provided that you can similarly provide us with some way of seeing any changes in your transcripts.

Thanks.

From: Pietrini, Jill [mailto:JPietrini@manatt.com]
Sent: Thursday, February 21, 2008 9:14 AM
To: Kane, Erik
Cc: Eliseev, Andrew; Merone, William
Subject: RE: Transcripts for Rita Perlman

Morning Erik -- that is fine to send to the DC office -- send to my attention. Also, please make sure we have errata sheets to indicate whatever changes were made, particularly since this is the third set of transcripts for Opposer's witnesses. I will let you know about exhibits when I return to LA. Thanks.

Jill Pietrini
manatt | phelps | phillips
11355 W. Olympic Blvd.
Los Angeles, CA 90064
(310) 312-4325
jpietrini@manatt.com

From: Kane, Erik [mailto:Ekane@kenyon.com]
Sent: Thursday, February 21, 2008 9:11 AM
To: Pietrini, Jill
Cc: Eliseev, Andrew; Merone, William
Subject: RE: Transcripts for Rita Perlman

Jill,

We actually have ready to go the finalized versions of all the transcripts. Rather than checking each one to see if you received the correct version from the court reporter, we will send you final copies of all the transcripts. You should have received exhibits for all the witnesses. As you indicated you did not receive Perlman's, I will have a copy set of her exhibits made for you. Let me know if you lack any exhibits for the other witnesses.

Also, unless you indicate otherwise, we will serve these final copies of all transcripts and exhibits to your DC office. Should it be to your or Andrew's attention?

- Erik

From: Pietrini, Jill [mailto:JPietrini@manatt.com]
Sent: Wednesday, February 20, 2008 6:22 PM
To: Kane, Erik
Cc: Eliseev, Andrew
Subject: Transcripts for Rita Perlman
Importance: High

Erik:

As I mentioned today before the testimony deposition of Frank Lopez, it does not appear that we received the testimony transcripts for Ms. Perlman, that were taken by Opposer U.S. Chamber of Commerce. Can you messenger copies of the full transcript and the miniscript and any exhibits used to our DC office tomorrow? Thank you.

Jill Pietrini
manatt | phelps | phillips
11355 W. Olympic Blvd.
Los Angeles, CA 90064
(310) 312-4325
jpietrini@manatt.com

IRS CIRCULAR 230 DISCLOSURE: To comply with requirements imposed by recently issued treasury regulations, we inform you that any U.S. tax advice contained in this communication (including any

Exhibit I

KENYON & KENYON LLP
Intellectual Property Law

Diane K.S. Shedd
Direct 202.220.4369
dshedd@kenyon.com

1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

February 21, 2008

Via Courier

Jill M. Pietrini, Esq.
MANATT, PHELPS & PHILLIPS LLP
700 12th Street, NW, Suite 1100
Washington, D.C. 20005

Re: The Chamber of Commerce of the United States v. United States Hispanic Chamber of Commerce Foundation, Opposition No. 91/156, 321

Dear Jill:

Enclosed please find a copy of the deposition transcripts of testimony and corresponding exhibits for the following:

Stephen Bokat
Patricia Cole
Karen Elzey
Christine Kanuch
Lydia C. Miles Logan
Lucia Olivera
Bradley Peck
Rita Perlman

The original transcripts and exhibits will be filed with the Trademark Trial and Appeal Board.

Very truly yours,

Diane Shedd

Diane K.S. Shedd
Litigation Paralegal

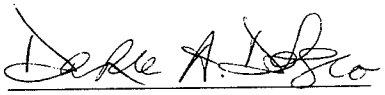
CERTIFICATE OF SERVICE

I hereby certify that copies of the deposition transcripts of testimony taken during Opposer's Testimony Period along with accompanying exhibits was served on the parties or counsel on the date and as indicated below:

By Courier

Jill M. Pietrini
MANATT PHELPS & PHILLIPS, LLP
700 12th Street, N.W.
Suite 1100
Washington, DC 20005

Date: February 21, 2008



Daria A. DeLizio

KENYON & KENYON LLP
1500 K Street, N.W.
Washington, D.C. 20005
Tel.: (202) 220 – 4200
Fax: (202) 220 – 4201

Counsel for Opposer, The Chamber of Commerce of the United States of America

Exhibit J

KENYON & KENYON LLP
Intellectual Property Law

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Direct 202.220.4369
dshedd@kenyon.com

1500 K Street, NW
Washington, DC 20005-1257
202.220.4200
Fax 202.220.4201

February 21, 2008

Via FedEx

Jill M. Pietrini, Esq.
MANATT, PHELPS & PHILLIPS LLP
700 12th Street, NW, Suite 1100
Washington, D.C. 20005

Re: The Chamber of Commerce of the United States v. United States Hispanic Chamber of Commerce Foundation, Opposition No. 91/156,321

Dear Jill:

Enclosed please find pages of the deposition transcripts of testimony reflecting errata changes for the following:

Stephen A. Bokat
Karen R. Elzey
Christine A. Kanuch
Lydia C. Miles Logan
Lucia H. Olivera
Bradley L. Peck

Very truly yours,

Diane K.S. Shedd
Litigation Paralegal

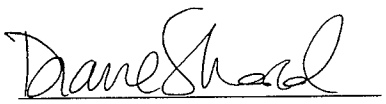
CERTIFICATE OF SERVICE

I hereby certify that pages of the deposition transcripts of Stephen A. Bokat, Karen R. Elzey, Christine A. Kanuch, Lydia C. Miles Logan, Lucia Olivera and Bradley L. Peck, reflecting errata changes, were served on the parties or counsel on the date and as indicated below:

Via FedEx

Jill M. Pietrini
MANATT PHELPS & PHILLIPS, LLP
700 12th Street, N.W.
Suite 1100
Washington, DC 20005

Date: February 21, 2008



Diane K.S. Shedd

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Washington, D.C. 20005
Tel.: (202) 220 – 4200
Fax: (202) 220 – 4201

Counsel for Opposer, The Chamber of Commerce of the United States of America

Commerce prior to 1983, then?

A. I was employed by the National Chamber Litigation Center beginning in 1977. The first five years I worked just for the affiliate.

Q. I'd like to focus on your position as general counsel at the U.S. Chamber of Commerce. What were your responsibilities as general counsel of the U.S. Chamber of Commerce?

A. I oversaw all legal issues involving the Chamber, including contracts and leases, intellectual property, and labor and employment issues. My job in general was to ensure the compliance of the Chamber with all laws and regulations, to advise the staff on what laws and regulations were applicable to it and to defend the organization in any litigation initiated against it, and occasionally to bring litigation when it was necessary on the Chamber's behalf. It was a typical in-house counsel's role.

Q. Now, looking at your position with the National Chamber Litigation Center, what were your duties there?

months ago, almost all, if not all, were members. There may be one or two that were not, but the vast, vast majority were members.

Q. Has the U.S. Chamber of Commerce ever taken a position that a local or regional Chamber of Commerce cannot use the words "Chamber of Commerce"?

A. No.

Q. Do you have a sense for how well known in the business community the U.S. Chamber of Commerce is?

MS. PIETRINI: Objection. Lacks foundation. Leading.

A. It's exceptionally well known. I mean, this is an organization that's in the papers every single day. Every day I would receive clips from the Chamber's media office of every mention of the Chamber in the media, and there are always at least dozens of references to it, it didn't have the exact text, and there were so many they would only provide texts from the major publications like the LA Times, the Washington Post, and so on.

It would include other places it would be

business. We were looking for cases that had a broad appeal to the whole business community. It might be a challenge to an OSHA regulation or a challenge to an EPA regulation that has an impact on a broad cross-section of the business community.

Q. So was it challenges to actual legislation or proposed legislation?

A. Well, it would be almost impossible to challenge proposed legislation. It would be federal government or state regulations, federal government or state statutes, but it would be hard to challenge something that was just proposed.

Q. Did the NCLC ever file a case on behalf of a Hispanic based business?

MR. COLBERT: Objection to the form of the question.

A. No, but we rarely ever filed on behalf of any particular business. These were generally done in the name of the Chamber of Commerce of the United States versus whomever it might be.

Q. I understand. That's one component. The other component is that you filed amicus briefs.

corporation, but we probably spend as much time, effort and money as we do with some of the other affiliates.

Q. And when did the U.S. Chamber of Commerce start its support of the AACCLA?

MR. COLBERT: Continuing objection. Beyond the scope of direct.

A. I don't know. Very long ago, and it may even have predated my arrival 30 years ago at the Chamber.

Q. But you don't know when it first started?

A. I don't know. It has had a relationship or an involvement with the Chamber for a very long time. It's certainly in excess of 20 years, and it may have predated my arrival at the Chamber in 1977.

Q. You mentioned something about the National Chamber Foundation and research and then you said seminars. What did you mean by that?

A. Well, they conduct research. They contract with researchers. They have their own staff that does some research on various legislative issues,

they were responsive to your discovery requests, I'm sure they were produced. They may not have been responsive. Certainly I do not recall your discovery requests as asking for everything that mentioned the U.S. Chamber of Commerce. I mean, that would be just an astronomical number of documents and clips and other things, so I don't recall that -- my recollection is not that your discovery asked for anything that general, but they may well have been produced.

Q. You're relying upon this, and by "you", the U.S. Chamber, is relying upon this media in order to support your testimony that the U.S. Chamber of Commerce is well known in business. Right?

MR. COLBERT: Could you read the question back, please?

(The record was read by the reporter.)

MR. COLBERT: I object to the question to the extent that it asks for communication of legal strategy as may be executed on behalf of the U.S. Chamber of Commerce. I object to the question in terms of vague, in terms of "rely" or "support". I

PROCEEDINGS

KAREN R. ELZEY,

a witness called for examination, having been first duly sworn, was examined and testified as follows:

EXAMINATION BY COUNSEL FOR OPPOSER

BY MR. MERONE:

Q. Good morning, Ms. Elzey.

A. Good morning.

Q. Can you just identify yourself, full name, please.

A. Sure.

Karen R. Elzey.

Q. And, Ms. Elzey, where are you presently employed?

A. I'm employed at the U.S. Chamber of Commerce's Institute for a Competitive Workforce.

Q. And what is your current role within the Institute for a Competitive Workforce?

A. I'm one of 2 executive directors of the

Institute for a Competitive Workforce.

Q. What does the Institute for a Competitive Workforce do?

A. ICW is a nonprofit affiliate of the U.S. Chamber of Commerce. It's a 501 C 3 that focuses on education and workforce issues to ensure that the business community has a skilled workforce today and in the future.

Q. Now, you mentioned that the institute is affiliated with the U.S. Chamber of Commerce.

How is that?

How are they affiliated again?

A. Sure.

We're a 501 C 3 affiliate of the U.S. Chamber of Commerce. We are housed within the same building as the U.S. Chamber of Commerce. All of the staff of ICW are employees of the U.S. Chamber. And we all receive the same benefits package as all other U.S. Chamber employees receive.

Q. So what does it mean to be a 501 C 3?

MS. PIETRINI: Objection lacks foundation.

Q. Or whatever the -- well, what does that

Workforce promote its affiliation with the U.S. Chamber?

A. One is because the U.S. Chamber -- we utilize the members of the U.S. Chamber of Commerce. Those are our constituents.

And we promote our affiliation because it's a positive promotion looking at the roles of the business community and ensuring that we're meeting the needs of the business community with regard to their education, training, and workforce needs.

Q. You mentioned that you're one of 2 executive directors at ICW.

Can you briefly describe what your position as an executive director entails.

A. Sure.

It entails -- we have federal grants that we receive, so it's managing those federal grants. We also have contributions from private foundations and corporate foundations.

It's being responsible for the financial self-sufficiency of the organization as well as outreach to other partners both in the business

community, the nonprofit community, the government, and fundraising as well and maintaining relationships and supervising 6 other staff people -- I think 6.

Q. How long have you been working with the U.S. Chamber?

A. I started at the U.S. Chamber of Commerce as a temporary employee in October of 2001, and I was hired full-time in April of 2002.

Q. So besides being an executive director and I guess having a temp job, what other positions have you held within the U.S. Chamber?

A. I started out full-time position as a program coordinator with the Institute for a Competitive Workforce, which at that time was known as the Center for Workforce Preparation.

I then moved up from a program coordinator to a I think director and then from a director to a senior director and a senior director to the executive director.

Q. Can you briefly describe the sort of work that you did before joining the U.S. Chamber.

A. Sure.

the importance of education.

Prior to ICW's formation, which legally came to be September of 2006, we were known as the Center for Workforce Preparation. Under the Center for Workforce Preparation, we had a long-standing relationship with the U.S. Department of Labor and their Job Corps program to promote Job Corps graduates to businesses who were not aware that the students were receiving skills and training, and that were then returning to their communities. The goal was to help the businesses identify another pool of skilled labor.

Under CWP, we'd also done a school-to-career tool kit to help businesses identify how they could better partner with their K through 12 education systems and what it meant to offer more hands-on and applied learning experiences to students.

We have done a project with community colleges with the American Association of Community Colleges that focused on market-responsive community colleges where they were meeting the needs of employers and therefore meeting the needs of the students who were entering community colleges.

could get engaged with a young person by offering an opportunity where a young person would come into the business and watch or shadow a full-time employee and learn about the skills needed in that job.

Also through ICW we've promoted ground hog job shadow day, which is a national program that's done that Junior Achievement and others helped sponsor. We brought young people in from the Job Corps centers. In the area in the past, they actually participated at the U.S. Chamber of Commerce. They participated not only within ICW, but also within other departments of the U.S. Chamber.

Q. Are you familiar with something called the national work readiness credential?

A. Yes.

We have a partnership with the National Work Readiness Council, which is an organization that has developed a new credential for entry-level workers. It was targeted at individuals who may have dropped out of high school, individuals who may not have certifications that are recognized in this country, or dislocated workers.

and did not hold a diploma.

Do you see where it discusses those issues?

A. Yes.

Q. Now, in your experience, is a concern over minority education also a concern to businesses?

A. Absolutely.

When we released our report card on February 28, one of the categories that we selected to analyze was academic achievement of low income and minority students. That was selected because the business community is concerned about where the future workforce is coming from, the demographic changes, and the realization that a high school graduation rate in this country is around 70 percent. For minority students, it's only around 50 percent.

And the majority of the jobs according to the Department of Labor require some type of postsecondary education after high school.

And we are already showing that we are missing quite a few students getting out of high school with even the ability to get advanced education.

exhibit 2?

MS. PIETRINI: Objection, foundation.

A. This would have been distributed to the steering committee of the business education partnership. It would have been distributed to other partners that were engaged in this network, such as Chambers of Commerce, associations, other corporations, and the natural distribution paths for the Business Civic Leadership Center.

BY MR. MERONE:

Q. What do you mean by, the natural distribution paths?

A. The members within The Chamber of Commerce usually receive documents done by the affiliates. Also it was used for fundraising as a way to introduce the Business Education Network and make connections for possible fundraising.

Q. You mentioned the Business Civic Leadership Center, which I think is referenced at the top of this document here.

What is the Business Civic Leadership Center?

Q. If you turn to page 54790, can you tell me what that is?

MS. PIETRINI: Objection, lacks foundation.

A. This is the attendee list for the 2005 Business Education Network summit, which indicates that about 400 people attended the conference.

BY MR. MERONE:

Q. Okay. If we look under E, that would include you?

A. Yes.

Q. Now, we earlier discussed ways in which the U.S. Chamber identifies itself with the activities of its affiliate organizations such as ICW or BCLC.

Did the U.S. Chamber also take steps to associate itself with the Business Education Network?

MS. PIETRINI: Objection, foundation.

A. Yes.

On the front page of the conference binder it's listed as the U.S. Chamber of Commerce Center for Corporate Citizenship, and then on the top, it listed the Business Education Network summit.

BY MR. MERONE:

critical and continues to get raised to the top of the list of the member organizations about how are we going to address the fact that 50 percent of minority students in this country do not complete high school.

BY MR. MERONE:

Q. What you mean by, English language learners?

A. English language learners are those students who are not native English speakers. They may speak some other language. It could be Spanish, French, Vietnamese, but their role in the school system as it relates specifically, it comes up with the criteria that we looked at around test scores and those tests that relate to No Child Left Behind, which is how we and the (NAEP) National Assessment for Education Progress, which is the assessment data that we used for our report card.

Q. Okay.

MR. MERONE: I have nothing further at this time.

- - -

(Recessed at 11:25 a.m.)

all?

Like do you know who the members are that are sending the money in?

MR. MERONE: Objection, vague.

A. I have a general awareness of who some members are, but I'm not directly -- that's not within the scope of my work.

BY MS. PIETRINI:

Q. Has anyone ever told you at the U.S. Chamber that the U.S. Chamber received membership fees that were intended for the Hispanic Chamber of Commerce?

A. I've never heard anything about that, no.

Q. Has anyone at the U.S. Chamber ever told you that they received membership fees that were intended for the Hispanic Chamber of Commerce Foundation?

A. Not that I'm aware of, no.

Q. And when you said, ICW received its own membership fees?

A. ICW is required to do its own fundraising. We are not a membership organization.

Q. So instead of membership fees, the ICW is funded by fundraising from various businesses?

A. That's correct.

Q. Are you involved in that in any respect?

A. Yes, I am.

Q. How are you involved in that?

A. I work with my co-executive director, Lydia Logan, on fundraising.

Q. Are you aware of the donors that provide fundraising to the ICW?

A. Yes, I am.

Q. Are any of those donors Hispanic-based businesses?

A. Not that I'm aware of, no.

Q. Have any of the fundraising amounts that the ICW has received -- were they intended for receipt by the Hispanic Chamber of Commerce?

A. Not that I'm aware of, no.

Q. Have any of the membership -- have any of the fundraising amounts that the ICW has received -- were any of them intended for receipt by the Hispanic Chamber of Commerce Foundation?

deal with.

They could be viewed as a competitor. At the same time, we choose to work with them so that we don't duplicate their efforts but we support their efforts.

Q. How does ICW go about getting its -- I know you don't have members per se.

A. That's correct.

Q. What do you call them?

A. Our fundraising efforts, much of the work that was done under CWP and has continued under ICW has been grants, which have specific deliverables. Those have been federal grants in many cases.

Q. CWP is the predecessor?

A. Predecessor with the Center for Workforce Preparation, the predecessor of ICW.

Q. What do you mean by, specific deliverables?

A. I mean, for example with exhibit 7, the Job Corps program, CWP wrote a grant to Job Corps that outlined exactly what we would do and how much it would cost. The Department of Labor then funded CWP to do that work, and we could only use that money to

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A. Essentially the same. It's more, I gained more authorization when I was promoted.

Q. Now, you mentioned, I believe, responsibility for certain aspects of U.S. Chamber of Commerce membership?

A. Yes.

Q. Could you, please, describe a little bit the types of membership of the U.S. Chamber of Commerce?

A. We have several levels of membership. Our highest level of membership is what we call our President's Advisory Group and National Accounts. Those are the larger companies. We have a next tier of membership, which is mid-cap. And then we have a tier of membership called the Small Business Group, which tend to represent the smaller companies.

We also have a membership class, which is our Federation Membership Program, which is a partnership with local chambers of commerces, as well as associations. We have memberships for associations and we have memberships for chambers of commerce.

state chambers of commerce and associations, whereby, the U.S. Chamber signs an agreement with one of those organizations and the U.S. Chamber provides free U.S. Chamber membership to the members of those organizations.

Q. Are the members of those organizations individuals or businesses?

A. Businesses.

Q. So as an example, the number 6,674 in the column 2004. What does that represent?

A. That represents 6,674 individual businesses.

Q. Now, I'll also note that there you have estimated numbers for associations and chambers of commerce prior to 2004 and after 2004 they appear to be not estimates; is that correct?

A. Yes.

Q. Could you please describe for the record why that is?

A. We converted the small businesses and associations and chambers over to a new system at the end of 2000. We are -- our focus was on the

small business side, because that's where our volume was, and developing reports there.

We began developing reports in the middle of 2004 on the associations and chambers of commerce. I had those reports available to me and pulled these numbers from them.

Q. Do you have an understanding of the distinction between an association and a chamber of commerce, as you've listed them on this document, Kanuch Number 1.

A. Yes.

Q. Could you describe for the record what that is?

A. An association will typically represent a single industry, whereas a chamber of commerce will represent all businesses typically within a geographical region for a specific group.

Q. Could you give us an example of an association?

A. The National Association of Manufacturers.

Q. Could you give an example, for the

at Exhibit Number 1, but we're not waiving any objections to this document.

The first category designated on this document is the small business category. My understanding is, from your testimony, that small businesses are those whose revenue is less than $10 million?

A. Correct.

Q. Where did you obtain numbers for years 2001 through 2006 for the category small businesses?

A. From reports that were generated in those years.

Q. Is this a cumulative number for all small businesses that are members of United States Chamber of Commerce?

MR. COLBERT: Object to form of the question as vague. You may answer if you can.

A. I don't know what you mean by cumulative.

Q. By cumulative I mean every business whose revenue is less than $10 million and is a member of the United States Chamber of Commerce, every such business is included in these numbers; is that

of commerces that are members of the U.S. Chamber of Commerce can form a partnership with the U.S. Chamber of Commerce to provide free U.S. Chamber memberships to the members of those associations or chambers of commerce.

Q. And you said that for the years 2001 through 2003 there are -- the program did not exist?

A. Correct.

Q. Okay. How did you obtain the numbers for the federation program for the years 2004 through 2006?

A. From management reports.

Q. Can you tell me exactly what is a management report?

A. It can take the form of queries that are run up against the database to summarize these numbers, basically count up the membership accounts. It can take a form of where I've taken that information and put it in more text to provide to senior management at the Chamber.

Q. So is a management report a summary of particular information like numbers of members and

words Chamber of Commerce on them?

MR. COLBERT: Objection; foundation. You may answer.

A. I would estimate that it would be somewhere in the two to three percent range.

Q. Were those somewherein the two to three percent range subtracted from the numbers that are appearing in this category or not?

A. They are included in this number.

Q. Why are they included in this number?

A. Well, because I pulled the postage and shipping figures directly from the tax returns.

Q. Your estimation of two to three percent, what is it based on?

A. My understanding of our business.

Q. Again, you did not look at any documents and did not have any discussions with anybody to come up with this estimate; correct?

A. Correct.

Q. The category for printing and publications, how did you obtain these numbers?

A. These numbers were obtained from the tax

expanded the scopes, so now instead of the BEN call it's the ICW monthly call, and we discuss our full range of issues, so, the 50-plus worker; we did one on -- some are education related, some are workforce related in terms of topics.

Q. Okay. And what are your primary responsibilities in ICW?

A. My primary responsibilities as executive director, it's a long list. It covers raising money to support the activities, managing the staff, overseeing our contracts, and carrying out the roles and responsibilities of our mission. So working with our state and local chambers, traveling around the country representing ICW and the U.S. Chamber of Commerce at times, particularly at regional conferences on education and workforce development, often sponsored by corporate members or state or local chambers.

Q. Okay. Now, Ms. Logan, the parties in this dispute include the U.S. Chamber of Commerce on our side and the U.S. Hispanic Chamber of Commerce or the U.S. Hispanic Chamber of Commerce Foundation

high school?

A. I don't recall exactly.

Q. You have four years of high school; right?

A. Yes.

Q. Do you know if there was ever a year that you did not take a course in Spanish?

A. I do not.

Q. Was it two years?

A. I don't recall.

Q. You have no reference point on the number of years that you took Spanish in high school?

A. I do not.

Q. Did you take Spanish in college?

A. I did take some Spanish in college.

Q. How many courses in Spanish did you take in college?

A. At least one.

Q. At least one. Any more than one?

A. I don't recall.

Q. Are you of Hispanic or Latino descent?

A. I am.

that do the fund raising with you?

MR. KANE: Objection; vague.

A. What do you mean by do the fund raising with me?

Q. Explain to me how you're involved in the fund raising for ICW.

A. I help to create budgets for the programs that we run and then solicit support from some members and some foundations and other sources of revenue to cover these events.

Q. So you solicit funds from members and then what was the other thing?

A. Private foundations and other sources.

Q. Okay. Members of who?

A. The U.S. Chamber of Commerce.

Q. Are any of those members that you have solicited funds from Hispanic-based businesses?

MR. KANE: Objection; vague.

A. I don't know. I mean it depends on how you define a Hispanic-based business.

Q. A business that is more than 50 percent owned by someone of Hispanic descent, operated by

join the call.

Q. How are you going to define work with? I'm okay with that because it's your business, but I just want to know how many chambers of commerce do you work with during your employment at the U.S. Chamber of Commerce and whether that's visits or the calls or however you would define it is fine with me.

MR. KANE: Objection; vague.

A. I'm trying to clarify, is that me individually or when you say you, you as ICW?

Q. You individually.

A. I have called, I don't know, I can't recall an exact number.

Q. Would it be more than a hundred?

A. No.

Q. So you've worked with less than a hundred chambers of commerce in the year and a half that you've been at the U.S. Chamber of Commerce?

A. Well, again, I want to be clear about worked with, because worked with the way we do our work, we have a broad reach. It could be something

Q. Did BEN do anything in its marketing efforts to target Hispanic-based businesses to participate in those monthly conference calls?

MR. KANE: Same objection.

A. Not specifically.

Q. Did they do anything generally to encourage Hispanic-based businesses to participate in those monthly conference calls?

MR. KANE: Same objection.

A. We market to all members, so to the extent that there could be members of the U.S. Chamber of Commerce or that are Hispanic-owned businesses or other kinds, they are all free to join the call.

Q. But nothing specifically targeted towards a Hispanic-based business to participate in those monthly conference calls; right?

MR. KANE: Objection; vague.

A. No.

Q. You talked on your direct examination about annual summit. What is that?

A. Each year we have a national conference,

attendees?

MR. KANE: Objection; vague. Calls for a legal conclusion.

A. Confuse? Could you restate it?

Q. Did any of the attendees that you met with at the 2006 summit, were any of them mistaken as to where you were employed?

A. I have no idea.

Q. No one said anything like, God, I think you work for a different chamber of commerce or just had a different name entirely for your employer?

A. Not that I recall.

Q. Did anyone at the 2006 ICW Annual Summit confuse where you worked with the U.S. Hispanic Chamber of Commerce?

MR. KANE: Objection; vague, calls for a legal conclusion.

A. I don't know.

Q. Did anyone mistakenly refer to you at that conference as being from the U.S. Hispanic Chamber of Commerce?

MR. KANE: Objection; vague.

Q. Okay. I'm just trying to understand your direct testimony on this, because you said that one of the activities of BEN and now ICW was these reports on education systems.

So I don't know how many reports. I'm asking you how many reports. You can understand my difficulty.

A. We have had one report on education systems.

Q. Okay. And then you had other reports while at BEN or ICW on education?

A. Yes.

Q. How many of those?

A. We have, we did one end-of-the-year report as BEN on business and education partnerships, and we have done another what could be called a report, another publication on education; our joint platform for education reform.

Q. So two plus the leaders and laggards?

A. Two plus leaders and laggards on education only.

Q. Okay. Are you doing -- has BEN or ICW

Q. Did you feel like you didn't have enough space when you were standing or --

A. No.

Q. -- there was plenty of space?

A. I felt like I had plenty of space.

Q. And then you said the title of this event was the Noche Tropical?

A. It's Noche Tropical.

Q. Was there a theme associated with this event?

A. Other than the name, not really. It was just a dancing fund raiser, silent auction.

Q. What does the name mean in English?

A. Tropical night.

Q. And then Mary's Center, you said that was a non-profit organization based in the metro area providing healthcare. Metro area is what?

A. Generally D.C. and the immediate surrounding counties.

Q. So you're not talking about Metro station?

A. No.

Q. Just the D.C. Metropolitan area?

A. Yes.

Q. You said it provided healthcare and social services to those who can't afford it; is that correct?

A. It provides healthcare and social services -- I don't know the parameters of how they define who they serve. Generally low-income constituents.

Q. How do you know that about the center?

A. When I was working at the Kimsey Foundation I had more information about them specifically. I have not looked at anything about their programs for a few years.

Q. And you also testified on direct that it includes the Hispanic community?

MR. KANE: Objection; vague.

Q. It services the Hispanic community?

A. They serve low-income families. I don't know if they target any particular group.

Q. I'm not asking about target. I'm asking if it includes the Hispanic community?

various positions you've held at the U.S. Chamber and the approximate times?

A. I started in May of 2005 as the administrative assistant to J. P. Moery. He was the senior vice president for Federation Relations. In March of 2006 I was promoted to associate manager for the Access America program, and in January of 2007 I was moved to a different department called the Institute For Organization Management.

Q. And when did you assume your present role?

A. Four weeks ago.

Q. Now, you mentioned Access America. Can you please describe what Access America is?

A. Access America is a program that was to provide information and resources to minority and women organizations. We had a website that had information on how to get certified if your business was 50 percent or more minority or women owned.

We were trying to provide information for people wanting to do business with bigger organizations, information on supplier diversity programs, trying to get more minority and women owned businesses to attend

A. I assisted Rita Perlman.
Q. What was Rita Perlman's title?
A. I don't recall exactly. Part of it, I believe, was executive director of Access America.
Q. Was she also a manager of Access America?
A. She was my boss, so she had to deal with the program.
Q. Do you know if there were any other directors or managers at Access America aside from Rita Perlman?
A. At the same time?
Q. Yes.
A. Not that I know of.
Q. As far as you know, she was the only director at Access America?
A. Yes.
Q. Do you know if she had a boss at Access America?
A. Yes.
Q. What was his or her name?
A. She had a lot of different bosses.
Q. At Access America she had a lot of bosses?
A. She had different bosses at different times. I believe when I started she reported to Anita Barrera.

Q. And what was Anita Barrera's title?
A. I don't recall.
Q. Who else?
A. I don't remember the name of the person before her.
Q. How many other people did Ms. Perlman report to?
MR. MERONE: I'll object as being beyond the scope of direct, and also to the extent you're seeking information outside the witness's knowledge.
Q. You said there were many people. How many? One? Five?
MR. MERONE: Same objection.
A. I don't know.
Q. Well, why did you say there were a lot of people?
MR. MERONE: Same objection.
A. I vaguely remember that she reported to different people.
Q. But you don't remember how many?
A. No.
Q. How do you know she was reporting to different people?
A. I don't really know. I believe that she had

Whereupon,

BRADLEY L. PECK,

called for examination by counsel for Opposer and having been duly sworn by the Notary Public, was examined and testified as follows:

(Peck Exhibit Nos. 1 through 53 were marked for identification.)

EXAMINATION BY COUNSEL FOR OPPOSER

BY MR. KANE:

Q. Good afternoon, Mr. Peck. For the record, can you please state your full name?

A. Bradley Lynn Peck.

Q. Mr. Peck, where are you currently employed?

A. The U.S. Chamber of Commerce.

Q. And what is your current role within the U.S. Chamber of Commerce?

A. I'm the senior director of communications publishing.

Q. And how long have you held that role?

A. Since the summer of 2005.

Business Civic Leadership Center, our group did the design and production of these two Websites to include the Chamber co-brand and the Monster Recruiting Through Professional Associations page, my group coordinated with Monster, the U.S. Chamber of Commerce co-branded at the top of that page.

Q. Can you explain what co-branding means?

A. Co-branding, this page actually exists on the Monster.com site, which we have a partnership with. We have a banner at the top of the page which includes links back to the U.S. Chamber site.

The Institute for Organizational Management also has their own branding, but they include a U.S. Chamber of Commerce co-brand with links back to the U.S. Chamber of Commerce main site at the top. And the Business Civic Leadership Center site also has its own brand name with U.S. Chamber of Commerce branding at the top with links back to the Website.

Q. Who is responsible at the U.S. Chamber for the co-branding?

A. The publishing group, which I oversee, is

A. Neal Hare.

Q. Then in the summer of 2005 you were promoted to the senior director of communications and publishing; correct?

A. I was actually made the director of communications and publishing. The decision was made to merge the Web team with the art department as part of a publishing group. And at that time Mr. Hare left the Chamber and the media department was also folded into the communications group and Linda Rossett took over. I was director of communications publishing then. I was promoted to senior director in January of this year.

Q. Do you report to anybody at that department?

A. I report to Linda Rozett.

Q. What is her title?

A. She's the senior vice president of communications.

Q. What does the art department exactly do?

A. The art department?

Q. Yeah.

resolution of Opposer's four motions to quash pending before a federal district court for the District of Columbia.

Respectfully submitted,

Date: February 27, 2008

/s/Jill M. Pietrini

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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 28th day of February, 2008.

/s/Monica Danner
Monica Danner

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document has been served upon the attorney for Applicant by depositing a copy thereof in an envelope addressed to: Erik Kane, Kenyon & Kenyon, 1500 K Street, N.W., Washington, DC 20005-1257, on this 27th day of February, 2008.

/s/Monica Danner
Monica Danner

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